(16,617.)

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1897.

No. 404.

THE UNITED STATES *EX REL.* ALFRED L. BERNARDIN, PLAINTIFF IN ERROR,

vs.

BENJAMIN BUTTERWORTH, COMMISSIONER OF PATENTS.

IN ERROR TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

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a Court of Appeals of the District of Columbia, April Term, 1897.

UNITED STATES *ex Rel.* ALFRED L. BERNARDIN, Appellant, *vs.* BENJAMIN BUTTERWORTH, Commissioner of Patents. } No. 682. Special Calendar, No. 6.

Appeal from the Supreme Court of the District of Columbia.

Supreme Court of the District of Columbia.

UNITED STATES *ex Rel.* ALFRED L. BERNARDIN *vs.* BENJAMIN BUTTERWORTH, Commissioner of Patents. } At Law. No. 40946.

UNITED STATES OF AMERICA, *District of Columbia,* } *ss:*

Be it remembered that in the supreme court of the District of Columbia, at the city of Washington, in said District, at the times hereinafter mentioned, the following papers were filed and proceedings had in the above-entitled cause, to wit:

1 In the Supreme Court of the District of Columbia.

Filed April 17, 1897.

UNITED STATES *ex Rel.* ALFRED L. BERNARDIN *vs.* BENJAMIN BUTTERWORTH, Commissioner of Patents. } At Law. 40946.

Petition for Mandamus.

The relator, Alfred L. Bernardin, says he is a citizen of the United States and residing in Evansville, Indiana, and that during the latter part of February, 1892, to wit, about the 25th day of February, he invented a new and useful improvement in metallic bottle-sealing devices, which was not known or used by others in this country, nor patented nor described in any printed publication in this or any foreign country before his invention or discovery thereof, nor in public use or on sale for more than two years prior to his application; that upon July 21st, 1892, he filed his application—serial No., 440,790—in the U. S. Patent Office for letters patent for the aforesaid device, of which your relator believes himself to be the first and original inventor; that the said application was made in writing in due form, as required by statute, in every particular,

and that your relator, Alfred L. Bernardin, filed therewith, in the Patent Office of the United States, a certain written description of the same, and the manner of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
2 art or science to which it appertains or with which it is most nearly connected to make, construct, and use the same, and did explain the principle thereof and the best mode in which he has contemplated applying that principle so as to distinguish it from all other inventions, and did particularly point out and distinctly claim the particular improvement and combination which he claims as his invention, as follows:

1st. A metallic bottle-sealing cap having its lower edge adapted to be pressed into contact with a locking shoulder and provided above the said edge with a circumferential outwardly projecting rib or bead for engagement by the removing tool.

2nd. The improved bottle-sealing cap herein described provided on its depending flange with an outwardly projecting rib or bead having its sections 1 and 2 approximately flat whereby to afford a firm bearing for engagement by the removing tool and having said sections joined at their outer edges by an acute bend, whereby such joint and the proximity of the sections 1 and 2 of the bead will tend to strengthen and give rigidity to said bead.

3rd. The combination substantially as described of the bottle having its neck provided with a locking shoulder and the cap fitted on said bottle pressed into continuous contact with the locking shoulder and provided with a circumferential outwardly projected bead arranged for engagement by the removing tool.

4th. The improvement in bottle closures substantially as herein described and shown consisting of the bottle provided near its lip with a locking shoulder, the cap fitted on said bottle and having its lower edge pressed into continuous contact with the locking shoulder and provided above said contact with an outwardly projecting bead having flat sections 1 and 2 and arranged for engagement by the removing tool.

5th. The combination substantially as herein described of the bottle provided with a locking shoulder, the cap fitted to said bottle and having the lower edge of its depending flange pressed into contact with the locking shoulder and provided above said lower edge with an outwardly projected portion having its upper side arranged below the top of the cap and adapted to form a bearing for engagement by the cap-removing tool.

6th. The metallic bottle-sealing cap having its lower edge adapted to be pressed into contact with a locking shoulder and provided above the said edge with a circumferential outwardly pro-
3 jecting rib or bead for engagement by the removing tool, said rib or bead having its upper side arranged below the plane of the top of the cap.

That said specification and claims were duly signed by your relator, Alfred L. Bernardin, as such inventor, and were duly attested by two witnesses.

That your relator, Alfred L. Bernardin, did further furnish draw-

ings of said invention, signed by the attorneys of your relator, Alfred L. Bernardin, and attested by two witnesses.

That your relator, Alfred L. Bernardin, did further make oath that he verily believed himself to be the original and first and sole inventor and discoverer of the same, for which he solicited a patent; that he did not know and did not believe that the same was ever before known or used, and did state the country whereof he was a citizen.

That your relator, Alfred L. Bernardin, did further, at the time of making such application, pay to John S. Seymour, the then Commissioner of Patents, all fees required by law.

That, upon the filing of such application and the payment of the fees required therefor by law, the said John S. Seymour, then Commissioner of Patents, did cause an examination to be made of the new invention set forth, contained, and described in said application, description, and drawings; that upon the said examination it was the opinion of the said John S. Seymour, then Commissioner of Patents, that the invention was new and useful; that your relator was the first and original inventor, and that your re-
4 lator was entitled to letters patent for his invention, and thereupon, on October 15, 1892, his application was allowed.

That on or about February 10, 1893, this application was withdrawn from issue for the purpose of interference, and on February 24th, 1893, upon due proceedings, an interference was declared with the application of William Painter—serial No., 458,549—filed January 16, 1893; that on March 31st, 1893, William H. Northall filed an application—serial No., 468,524—for letters patent for the same invention, which application was on April 7, 1893, added to said interference between Bernardin and Painter; that the case of this interference duly coming on to be heard before the examiner of interferences according to statutes, rules, and regulations of the Patent Office in that case made and provided, upon the respective statements, testimony, and proofs of your relator, said Northall, and said Painter, prepared and presented according to the rules and regulations of the Patent Office, the examiner of interferences did decide that said William H. Northall was the original and first inventor of the said improvement in bottle-sealing devices, and that he was entitled to letters patent therefor.

That your relator, Alfred L. Bernardin, then appealed from this decision to the examiners-in-chief, according to the provisions of the statute and the rules and regulations of the Patent Office, and on May 16, 1894, the decision of the examiner of interferences was affirmed by them.

That your relator, Alfred L. Bernardin, then appealed from the decision of the examiners-in-chief to the said John S. Seymour,
5 then Commissioner of Patents, according to the statute and the rules and regulations of the Patent Office, and that on March 23, 1895, the said John S. Seymour, then Commissioner of Patents, reversed the decision of the examiners-in-chief and decided that your relator, Alfred L. Bernardin, was the first and original inventor of the said invention and entitled to letters patent for his

invention in accordance with the terms and claims of his application.

That said letters patent would have been issued in accordance with the said finding and decision of said John S. Seymour, then Commissioner of Patents, but for that, under the statute of the United States in such case made and provided, and in accordance therewith the said William H. Northall prosecuted an appeal to the Court of Appeals of the District of Columbia, in which said appeal the testimony taken before the Commissioner, and which was submitted for his consideration, and that alone was or could under the statute properly be filed in said Court of Appeals, and the errors alleged to have been committed by the Commissioner in rendering said decision, which in said petition are called reasons of appeal, were assigned, and the entire record filed as aforesaid with the Court of Appeals of the District of Columbia, and said court entertained and exercised jurisdiction in the matter of said appeal on error.

And subsequently, to wit, on the 12th day of November, 1895, the case was heard upon the record filed as aforesaid, and, upon consideration, the court reversed the findings of the Commissioner, a copy of which said decision is hereto attached and marked
6 "Exhibit A" and made a part hereof for reference; that a certified copy of said decision was filed with the Commissioner of Patents.

And your relator further presents that he, being advised by counsel learned in the law and believing that it was the duty of the said John S. Seymour, then Commissioner of Patents, as a result of his finding and decision that your relator was entitled to have granted and issued to him letters patent for said invention, which decision the said Commissioner never in any way modified or changed, to issue to him said letters, formally tendered to the said Commissioner of Patents the legal fee of twenty dollars, with the request that said letters patent be issued to him, which said request the said John S. Seymour, then Commissioner of Patents, refused; whereupon your relator moved this honorable court for a writ of peremptory mandamus against the said John S. Seymour, then Commissioner of Patents, commanding him to issue said letters patent to your relator in conformity with his said decision, which cause coming on to be heard before his honor Judge McComas, he, on the — day of ——, denied the motion; whereupon your relator appealed from the decision of this honorable court to the Court of Appeals, in which said court the case was pending, on the 12th day of April, 1897, when the term of office of the said John S. Seymour as Commissioner of Patents expired, and in consequence thereof the action of your said relator against the said John S. Seymour, Commissioner of Patents, abated.

7 Your relator further shows that on the 12th day of April, A. D. 1897, the Honorable Benjamin Butterworth became Commissioner of Patents in the place and stead of the said John S. Seymour; whereupon your relator, being advised by counsel learned in the law and believing that it was the duty of the said Benjamin

Butterworth, Commissioner of Patents, to issue to your relator letters patent for his said invention, formally tendered to the said Benjamin Butterworth, Commissioner, the legal fee of twenty dollars, with the request that said patent should be issued to him.

And your relator shows that the said Benjamin Butterworth, Commissioner, having examined the case and being familiar with the circumstances thereof, was and is of the opinion that your relator was and is entitled to have and receive letters patent for the said invention, and that the said William H. Northall was not and is not entitled to have issued to him said letters patent as the first inventor; yet, because of the decision of the Court of Appeals rendered in the proceeding as hereinbefore mentioned, deciding that the said Northall was the first inventor, he, the said Commissioner, deemed himself concluded from taking any further or other action than to issue said letters patent to said William H. Northall and refused and still refuses to issue said letters patent to your relator; all of which will more fully appear by a copy of the letter of your relator to the said Benjamin Butterworth, Commissioner of Patents, and by a copy of the letter of the said Benjamin Butterworth, Commissioner of Patents, to your relator, filed herewith and marked Exhibits "B" and "C" and prayed to be taken and read as a part of this motion.

And, further, your relator presents that notwithstanding
8 the act of Congress approved February the 9th, 1893, in form, confers jurisdiction upon the Court of Appeals of the District of Columbia to hear the appeal on error prosecuted from the action of the Commissioner of Patents, an officer of the executive department of the Government, and to review the official action of said officer of the executive department and to revise and reverse or nullify said action; that said statute is to the extent that it attempts to confer jurisdiction upon the Court of Appeals of the District of Columbia to review, reverse, or nullify the action of the executive branch of the Government, unconstitutional, inoperative, and void, and the decision rendered and certified in that behalf is *coram non judice* for want of constitutional authority to entertain, hear, and control by judicial action the official acts of the executive department.

And your relator further presents that the Honorable John S. Seymour, the then Commissioner of Patents, having decided that your relator was entitled to said patent, which said decision the present Commissioner of Patents, the Honorable Benjamin Butterworth, does not in any way impugn, deny, or attempt to overrule, but, on the contrary, announces that he it satisfied of the entire justice of the same and of the right of your relator to have issued to him the patent, as prayed for, but denies, on account of the decision of the Court of Appeals aforesaid, to issue the same to your relator; wherefore your relator shows that it is the duty of the said Benjamin Butterworth, Commissioner of Patents, to grant and issue to your relator letters patent for his said invention.

Wherefore your relator comes and respectfully asks—

That a writ of peremptory mandamus may issue from this
9 honorable court to the said Benjamin Butterworth, Commissioner of Patents, commanding him to issue said letters patent to your relator in conformity with the decision of the said John S. Seymour, late Commissioner of Patents, and in accordance with the claims of your relator's application, as above stated.

ALFRED L. BERNARDIN.

STATE OF INDIANA,
County of Vanderburgh, } ss:

Alfred L. Bernardin, being duly sworn, deposes and says that he is the relator named in the foregoing petition; that he has read said petition and knows the contents thereof; that the statements therein contained are true of his own knowledge and belief except as to matters therein stated on information and belief, and as to such matters he believes them to be true.

ALFRED L. BERNARDIN.

Subscribed and sworn to before me this 12th day of April, A. D. 1897.

[L. S.]

PERCY C. HOPKINS,
Notary Public.

10 EXHIBIT B.

APRIL 13TH, 1897.

Hon. Benjamin Butterworth, Commissioner of Patents, Washington, D. C.

SIR: On July 21st, 1892, I filed my application in writing in the United States Patent Office—serial No., 440,790—for letters patent for a new and useful improvement in metallic bottle-sealing devices. This application was in due form, as required by statute, and was accompanied by all descriptions, specifications, oaths, drawings, and claims, as required by law and in the form and of the substance required by law. At the same time I paid to the Hon. John S. Seymour, at that time Commissioner of Patents, all fees required by law, upon which Commissioner Seymour caused an examination to be made of my invention as set out in my application, and on October 15, 1892, decided that I was entitled to a patent therefor. On February 10, 1893, my application was withdrawn from issue for the purpose of interference, and on February 24, 1893, an interference was declared with the application of William Painter—serial No., 458,549. On March 31, 1893, William H. Northall filed an application—serial No., 468,524—for letters patent for the same invention, which application was on April 7, 1893, added to the interference between Painter and myself.

The case of this interference duly coming on to be heard the Commissioner of Patents, the Honorable John S. Seymour, on March 23, 1895, decided that I was the first and original inventor of said invention and entitled to letters patent for the same in accordance with the terms and claims of my application.

The letters patent would have issued in accordance with the finding and decision of the said Commissioner of Patents, but for the fact that the said William H. Northall prosecuted an appeal from the decision of the Commissioner of Patents to the Court of Appeals of the District of Columbia, which court on November 12, 1895, rendered a decision, in terms, reversing and overruling the decision of the said Commissioner of Patents, and finding and deciding that the said William H. Northall and not myself was entitled to letters patent for the said invention.

This decision, I present, was and is entirely null and void, and was in no way binding upon the former Commissioner, Mr. Seymour, nor is it binding upon you. The decision is *coram non judice*, the matter not being one properly determinable by the said Court of Appeals on appeal from the Commissioner of Patents, an officer of the executive branch of the Government. The act of Congress in terms conferring upon the Court of Appeals the jurisdiction it has sought to exercise in this case is unconstitutional and void.

11 Believing that the whole proceedings of appeal from the decision of the Commissioner of Patents were void I made demand, accompanied by a tender of the final fee as required by law, upon the said John S. Seymour, the Commissioner of Patents, for letters patent to be issued to me in accordance with his decision that I was entitled to the same, which demand the said Commissioner of Patents refused and so continued to refuse until April 13th, 1897, when his term of office expired and you were inducted in the office of Commissioner of Patents in his place and stead.

I herewith tender to you the sum of twenty dollars, the same being the amount of the final fee required by law, and respectfully request that letters patent be issued to me in accordance with my application heretofore made as above set out and in accordance with the decision of your predecessor in office, the Honorable John S. Seymour, that I was entitled to have issued to me said letters patent.

Very respectfully,

ALFRED L. BERNARDIN,
By JULIAN C. DOWELL,
His Attorney.

(Dictated.)

12 DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., *April* 16, 1897.

Julian C. Dowell, Esq., attorney-at-law, Loan & Trust building, Washington, D. C.

SIR: I have your letter of April 13, 1897, tendering the final fee and requesting that patent be issued to Alfred L. Bernardin on application filed July 21, 1892, No. 440,790, in accordance with the decision of the Commissioner of Patents, notwithstanding the reversal of that decision by the Court of Appeals of the District of Columbia. Your request cannot be granted, for the reason that

Congress has provided for an appeal from the decision of the Commissioner of Patents to the Court of Appeals, and the court is authorized by statute, in the exercise of that jurisdiction, to revise, modify, reverse, or annul the decision of the Commissioner of Patents in any appealable case.

Until it is settled by proper adjudication that the act conferring such appellate jurisdiction is unconstitutional, the Commissioner will obey the mandate of the Court of Appeals and issue patents in accordance therewith. In this particular case, with which I am thoroughly familiar, the decision of the Commissioner of Patents, my predecessor, was in favor of Bernardin, he having been adjudged to be the sole and first inventor of the device in controversy, and there remained nothing to be done except to issue the patent. An appeal, however, was prosecuted to the Court of Appeals, as hereinbefore stated, and the judgment of the Commissioner was reversed. Thereafter, in order to test the constitutionality of the law and to determine whether jurisdiction could be conferred upon the court to entertain appeals from and on such appeal revise, modify, reverse, or annul the official acts of the Commissioner of Patents, an officer of an executive department of the Government, a petition was filed in the supreme court of the District of Columbia for a writ of mandamus to compel Commissioner Seymour to issue a patent to Bernardin, notwithstanding the decision of the circuit court of appeals. An alternate writ was allowed and proper return made in accordance with the facts. The petition was dismissed, and an appeal was taken to the Court of Appeals of the District of Columbia. The case was heard and, upon consideration, the court sustained the jurisdiction, though entertaining a doubt as to the constitutionality of the law.

It was understood that the case would be taken to the Supreme Court, that the question might be fully and finally determined, but there was not time before the expiration of the term of Commissioner Seymour to do this. That the question should be settled is clear. I will do everything in my power as Commissioner to facilitate this.

If the Court of Appeals can properly exercise jurisdiction to
13 entertain an appeal and revise, modify, or annul on appeal and practically and in effect review on petition in error on the record the official acts of an officer of an executive department, acting within the scope of his departmental jurisdiction, then the patent should not issue to Bernardin. On the other hand, if the law conferring this jurisdiction is, as is contended by you, and as I have urged before I was Commissioner, unconstitutional because it confuses and obliterates the lines which mark the boundary between the several departments of the Government and makes one subordinate to another, then and in that case the patent should issue to Bernardin, as there remains nothing to be done except the administrative act of preparing and issuing the patent. But because of the decision of the Court of Appeals I decline to comply with your request.

I trust if any step is to be taken it may be done immediately, in order that no time be lost in having this question finally settled.

Very respectfully yours,

BENJ. BUTTERWORTH,
Commissioner.

14 In the Supreme Court of the District of Columbia.

UNITED STATES *ex Rel.* ALFRED L. BERNARDIN *vs.* BENJAMIN BUTTERWORTH, Commissioner of Patents.	At Law. No. 40946.

Upon consideration of the petition for mandamus in the above-entitled cause, it is ordered, on this 20th day of April, A. D. 1897, that the respondent herein show cause, on the 26th day of April, A. D. 1897, at 10 o'clock a. m., before me at the special term of this court, why an alternate writ of mandamus, as prayed for, should not issue, provided a copy of this order and of the petition filed in this cause be served upon the respondent on or before the 21st day of April, A. D. 1897.

L. E. McCOMAS,
Associate Justice Supreme Court of the District of Columbia.

Marshal's Return.

Served copy of within order, also copy of the petition filed in this cause, on within-named respondent April 20, 1897.

ALBERT A. WILSON, *Marshal.*

15 In the Supreme Court of the District of Columbia.

UNITED STATES *ex Rel.* ALFRED L. BERNARDIN *v.* BENJAMIN BUTTERWORTH, Commissioner of Patents, Respondent.	Filed April 24, 1897. At Law. No. 40946.

Answer of Respondent.

The respondent, Benjamin Butterworth, Commissioner of Patents, respectfully makes return to the order of the Honorable L. E. McComas, associate justice of the supreme court of the District of Columbia, made on the 20th day of April, 1897, in the above-entitled matter, to show cause why a writ of mandamus should not issue commanding him to issue letters patent to the relator as prayed for in the petition upon which said order was granted, and says:

That the facts set forth in the relator's petition as to the respondent's refusing to issue a patent to your relator are true.

It is further stated that your respondent based his refusal to grant a patent to Bernardin wholly on the ground that Congress has provided for an appeal from the decision of the Commissioner of Patents

o the Court of Appeals of the District of Columbia, and the court is authorized by said statute, in the exercise of that jurisdiction, to revise, modify, review, or annul the decision of the Commissioner of Patents in any appealable case.

It is further stated that whether or not the act approved February 9, 1893, conferring jurisdiction upon the Court of Appeals of the District of Columbia to hear and decide appeals on error prosecuted from the decisions of the Commissioner of Patents, an officer of the executive department of the Government, is constitutional, the Commissioner is not advised.

It is further stated that if the decision of the Commissioner
16 of Patents, which is that Alfred L. Bernardin, the relator, is the first and original inventor of the invention in controversy and is entitled to receive a patent as prayed for is final, and if, upon such decision, it is the lawful duty of the Commissioner of Patents to accept the final fee and issue a patent to Bernardin as prayed. then the Commissioner of Patents has improperly refused to accept the fee and to prepare said patent for issue; but if the decision of the Commissioner of Patents is subject to revision and reversal on appeal to the Court of Appeals of the District of Columbia, then such refusal on the part of the Commissioner of Patents to accept the final fee and issue the patent to Bernardin, the relator, is right and proper.

Your respondent states that it — his desire to have the jurisdiction of the Court of Appeals of the District of Columbia speedily and finally determined for the future guidance of the Patent Office and in the interests of the applicants appearing before it.

And, having fully answered, he prays judgment.

BENJ. BUTTERWORTH,
Commissioner.

April 23, 1897.

17 In the Supreme Court of the District of Columbia.

UNITED STATES *ex Rel.* ALFRED L. BERNARDIN *vs.* BENJAMIN BUTTERWORTH, Commissioner of Patents.	At Law. No. 40946.

This cause coming on to be heard upon the relator's petition for a writ of mandamus against the respondent and counsel having been heard thereon, it is thereupon, on due consideration thereof, this 26th day of April, 1897, by the court ordered and adjudged that the rule to show cause is hereby discharged and the petition be, and the same is hereby, dismissed at the costs of relator.

Petitioner in this cause having prayed an appeal to the Court of Appeals of the District of Columbia from the judgment of this court dismissing the petition, the same is allowed and bond is fixed in the penalty of two hundred dollars.

L. E. McCOMAS,
Asso. Justice.

18 In the Supreme Court of the District of Columbia.

UNITED STATES *ex Rel.* ALFRED L. BERNARDIN *vs.* BENJAMIN BUTTERWORTH, Commissioner of Patents.	At Law. No. 40946.

In accordance with the consent of counsel on both sides and upon motion of relator's attorney in the above-entitled case, leave is hereby given the relator to file a transcript of the record of the case of United States *ex rel.* Alfred L. Bernardin *vs.* John S. Seymour, Commissioner of Patents, No. 40029, and to use the exhibits in the said transcript as exhibits in this case.

L. E. McCOMAS,
Asso. Justice.

19 In the Supreme Court of the District of Columbia.

UNITED STATES *ex Rel.* ALFRED L. BERNARDIN *vs.* BENJAMIN BUTTERWORTH, Commissioner of Patents.	Filed April 28, 1897. At Law. No. 40946.

The clerk will please note an appeal in the above-entitled cause to the Court of Appeals of the District of Columbia from the order of the court entered April 26, 1897, dismissing the petition for mandamus and issue citation to the appellee.

JULIAN C. DOWELL,
Att'y for Alfred L. Bernardin.

April 27, 1897.

[Endorsed:] At law. No. 40946. In the supreme court of the District of Columbia. United States *ex rel.* Alfred L. Bernardin *vs.* Benjamin Butterworth, Commissioner of Patents.

20 In the Supreme Court of the District of Columbia.

UNITED STATES *ex Rel.* ALFRED L. BERNARDIN *vs.* BENJAMIN BUTTERWORTH, Commissioner of Patents.	Filed April 28, 1897. At Law. No. 40946.

It is hereby stipulated and agreed by and between counsel for the parties that a transcript of the record of the case of United States *ex rel.* Alfred L. Bernardin *vs.* John S. Seymour, Commissioner of Patents, No. 40029, may be filed and used as a part of the record in this case and that the exhibits in said transcript may be used as exhibits in this case, and issue and citation are hereby waived.

JULIAN C. DOWELL,
Att'y for Alfred L. Bernardin.
W. A. MEGRATH,
Att'y for Comm'r of Patents.

April 26, 1897.

[Endorsed:] At law. No. 40946. In the supreme court of the District of Columbia. United States *ex rel.* Alfred L. Bernardin *vs.* Benjamin Butterworth, Commissioner of Patents. Stipulation.

21 *Memorandum.*

Apr. 30, '97.—Appeal bond filed.

22 Supreme Court of the District of Columbia.

UNITED STATES OF AMERICA, *District of Columbia,* } *ss:*

I, John R. Young, clerk of the supreme court of the District of Columbia, do hereby certify that the foregoing pages, numbered from 1 to 21, inclusive, are true copies of originals in cause No. 40946, at law, wherein United States *ex rel.* Alfred L. Bernardin is plaintiff and Benjamin Butterworth, Commissioner of Patents, is defendant, as the same remains upon the files and records of said court.

Seal of the Supreme Court of the District of Columbia.

In testimony whereof I hereunto subscribe my name and affix the seal of said court, at the city of Washington, in said District, this 3rd day of May, A. D. 1897.

JOHN R. YOUNG, *Clerk.*

23 *Transcript of Record.*

Court of Appeals, District of Columbia, October Term, 1896.

THE UNITED STATES *ex Rel.* ALFRED L. BERNARDIN, Appellant, *vs.* JOHN S. SEYMOUR, Commissioner of Patents. } No. 603. No. 7, Special Calendar.

Appeal from the supreme court of the District of Columbia.

Filed July 22, 1896.

24 In the Court of Appeals of the District of Columbia.

THE UNITED STATES *ex Rel.* ALFRED L. BERNARDIN, Appellant, *vs.* JOHN S. SEYMOUR, Commissioner of Patents. } No. 603.

Supreme Court of the District of Columbia.

UNITED STATES *ex Rel.* ALFRED L. BERNARDIN *vs.* JOHN S. SEYMOUR, Commissioner of Patents. } At Law. No. 40029.

UNITED STATES OF AMERICA, *District of Columbia,* } *ss:*

Be it remembered that in the supreme court of the District of Columbia, at the city of Washington, in said District, at the times

hereinafter mentioned, the following papers were filed and proceedings had in the above-entitled cause, to wit:

Petition for Mandamus & Exhibit "A."

Filed June 15, 1896.

In the Supreme Court of the District of Columbia.

UNITED STATES *ex Rel.* ALFRED L. BERNARDIN
vs.
JOHN S. SEYMOUR, Commissioner of Patents. } At Law. 40029.

Motion for mandamus.

The relator, Alfred L. Bernardin, says he is a citizen of the United States and residing in Evansville, Indiana, and that during the latter part of February, 1892, to wit, about the 25th day of February, he invented a new and useful improvement in metallic bottle-sealing devices, which was not known or used by others in this country, nor patented nor described in any printed publication in this or any foreign country before his invention or discovery thereof, nor in public use or on sale for more than two years prior to his application; that upon July 21, 1892, he filed his application—serial No., 440,790—in the U. S. Patent Office for letters patent for the aforesaid device, of which your relator believes himself to be the first and original inventor; that the said application was made in writing in due form as required by statute in every particular, and that your relator, Alfred L. Bernardin, filed therewith in the Patent Office of the United States a certain written description of
25 the same and the manner of making and using it in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains or with which it is most nearly connected to make, construct, and use the same, and did explain the principle thereof and the best mode in which he has contemplated applying that principle so as to distinguish it from all other inventions, and did particularly point out and distinctly claim the particular improvement and combination which he claims as his invention, as follows:

1st. A metallic bottle-sealing cap having its lower edge adapted to be pressed into contact with a locking shoulder, and provided above the said edge with a circumferential outwardly projecting rib or bead for engagement by the removing tool.

2nd. The improved bottle-sealing cap herein described, provided on its depending flange with an outwardly projecting rib or bead, having its sections 1 and 2 approximately flat, whereby to afford a firm bearing for engagement by the removing tool, and having said sections joined at their outer edges by an acute bend, whereby such joint and the proximity of the sections 1 and 2 of the bead will tend to strengthen and give rigidity to said bead.

3rd. The combination substantially as described of the bottle having its neck provided with a locking shoulder, and the cap fitted

on said bottle, pressed into continuous contact with the locking shoulder, and provided with a circumferential outwardly projected bead arranged for engagement by the removing tool.

4th. The improvement in bottle closures substantially as herein described and shown, consisting of the bottle provided near its lip with a locking shoulder, the cap fitted on said bottle and having its lower edge pressed into continuous contact with the locking shoulder, and provided above said contact with an outwardly projecting bead, having flat sections 1 and 2, and arranged for engagement by the removing tool.

5th. The combination substantially as herein described of the bottle provided with a locking shoulder, the cap fitted to said bottle and having the lower edge of its depending flange pressed into contact with the locking shoulder and provided above said lower edge with an outwardly projected portion, having its upper side arranged below the *the* top of the cap and adopted to form a bearing for engagement by the cap-removing tool.

6th. The metallic bottle-sealing cap having its lower edge adapted to be pressed into contact with a locking shoulder and provided above the said edge with a circumferential outwardly projecting rib or bead for engagement by the removing tool, said rib or bead having its upper side arranged below the plane of the top of the cap.

That said specification and claims were duly signed by your relator, Alfred L. Bernardin, as such inventor, and were duly attested by two witnesses.

That your relator, Alfred L. Bernardin, did further furnish
26 drawings of the said invention, signed by the attorneys of your relator, Alfred L. Bernardin, and attested by two witnesses.

That your relator, Alfred L. Bernardin, did further make oath that he verily believed himself to be the original and first and sole inventor and descoverer of the same, for which he solicited a patent; that he did not know and did not believe that the same was ever before known or used, and did state the country whereof he was a citizen.

That your relator, Alfred L. Bernardin, did further at the time of making such application pay to the said Commissioner of Patents all fees required by law.

That upon the filing of such application and the payment of the fees required therefor by law the said Commissioner of Patents did cause an examination to be made of the new invention set forth, contained, and described in said application, description, and drawings; that upon the said examination it was the opinion of the Commissioner of Patents that the invention was new and useful; that your relator was the first and original inventor, and that your relator was entitled to letters patent for his invention, and thereupon, on October 15, 1892, his application was allowed.

That on or about February 10, 1893, this application was withdrawn from issue for the purpose of interference, and on February 24th, 1893, upon due proceedings and interference was declared with the application of William Painter—serial No., 458,549—filed

January 16, 1893; that on March 31st, 1893, William H. Northall filed an application—serial No., 468,524—for letters patent for the same invention, which application was on April 7, 1893, added to said interference between Bernardin and Painter; that the case of this interference duly coming on to be heard before the examiner of interferences according to statute, rules, and regulations of the Patent Office in that case made and provided, upon the respective statements, testimony, and proofs of your relator said Northall and said Painter prepared and presented according to the rules and regulations of the Patent Office, the examiner of interferences did decide that said William H. Northall was the original and first inventor of the said improvement in bottle-sealing devices, and that he was entitled to letters patent therefor.

That your relator, Alfred L. Bernardin, then appealed from this decision to the examiners-in-chief, according to the provisions of the statute and the rules and regulations of the Patent Office, and on May 16, 1894, the decision of the examiner of interferences was affirmed by them.

That your relator, Alfred L. Bernardin, then appealed from the decision of the examiners-in-chief to the Commissioner of Patents according to the statute and the rules and regulations of the Patent Office, and that on March 23, 1895, the Commissioner of Patents reversed the decision of the examiners-in-chief and decided that your relator, Alfred L. Bernardin, was the first and original inventor of the said invention, and entitled to letters patent for his invention in accordance with the terms and claims of his application.

27 That said letters patent would have been issued in accordance with the said finding and decision of said Commissioner of Patents but for that, under the statute of the United States in such case made and provided and in accordance therewith, the said William H. Northall prosecuted an appeal to the Court of Appeals of the District of Columbia, in which said appeal the testimony taken before the Commissioner and which was submitted for his consideration, and that alone, was or could under the statute properly be filed in said Court of Appeals, and the errors alleged to have been committed by the Commissioner in rendering said decision, which in said petition are called reasons of appeal, were assigned and the entire record filed as aforesaid with the Court of Appeals of the District of Columbia, and said court entertained and exercised jurisdiction in the matter of said appeal on error.

And subsequently, to wit, on the 12th day of November, 1895, the case was heard upon the record filed as aforesaid, and upon consideration the court reversed the findings of the Commissioner, a copy of which said decision is hereto attached and marked "Exhibit A" and made a part hereof for reference; that a certified copy of said decision was filed with the Commissioner of Patents.

And your relator further presents that being advised by counsel learned in the law and believing that it was the duty of the Commissioner, as a result of his finding and decision, that your relator was and is entitled to have granted and issued to him letters patent

for said invention, and which said opinion and decision he has in nowise changed or modified, that it was and is his duty, in conformity with said decision—he, the said Commissioner, not desiring to inquire further, but being satisfied that your relator is entitled to have said patent issued to him—to issue said letters patent to your relator.

And further your relator presents that notwithstanding the act of Congress approved February 9th, 1893, in form confers jurisdiction upon the Court of Appeals for the District of Columbia to hear the appeal on error prosecuted from the action of the Commissioner of Patents, an officer of the executive department of the Government, and to review the official action of said officer of the executive department and to revise and reverse or nullify said action, that said statute is to the extent that it attempts to confer jurisdiction upon the Court of Appeals of the District of Columbia to review, reverse, or nullify the action of the executive branch of the Government unconstitutional, inoperative, and void, and the decision rendered and certified in that behalf is *coram non judice* for want of constitutional authority to entertain, hear, and control by judicial action the official acts of the executive department.

And your relator further presents that the honorable Commissioner of Patents having decided that your relator is entitled to said patent, and when said Commissioner would have issued said patent to your relator, but for the decision aforesaid of the said Court of Appeals for the District of Columbia, your relator formally tendered the final fee due to the Government upon the al-
28 lowance of the application for a patent upon the decision of said Commissioner that your relator was and is entitled to have and receive said patent, and the honorable Commissioner being fully satisfied in that behalf, and having so found and adjudged and not desiring to make further inquiry in any behalf, your relator did tender the legal fee of $20, with the request that said patent should be issued to him; and thereupon said Commissioner, although he had in nowise changed his mind, and although he had decided and had in nowise changed his mind, that the said William H. Northall was not entitled to have or receive a patent and was not the first inventor, yet because of the decision of the Court of Appeals for the District of Columbia rendered in the proceeding in error as hereinbefore mentioned, he deemed himself concluded from taking any further or other action than to issue said patent to said William H. Northall, and for that reason only he refused to issue said patent to your relator.

Wherefore your relator comes and respectfully asks—

That a writ of peremptory mandamus may issue from this honorable court to the said Commissioner of Patents, commanding him to issue said letters patent to your relator in conformity with his said decision and in accordance with the claims of your relator's application as above stated.

ALFRED L. BERNARDIN.

STATE OF INDIANA, }
County of Vanderburgh, } ss:

Alfred L. Bernardin, being duly sworn, deposes and says that he is the relator named in the foregoing petition; that he has read said petition and knows the contents thereof; that the statements therein contained are true of his own knowledge and belief, except as to those matters therein stated on information and belief, and as to such matters he believes them to be true.

ALFRED L. BERNARDIN.

Subscribed and sworn to before me this 11th day of June, A. D. 1896.

[SEAL.] H. I. BENNETT,
Notary Public, D. C.

29 "EXHIBIT A."

Filed June 15, 1896.

In the Supreme Court of the District of Columbia.

UNITED STATES *ex Rel.* ALFRED L. BERNARDIN }
vs. } At Law.
JOHN S. SEYMOUR, Commissioner of Patents. }

This is an appeal from the decision of the Commissioner of Patents in an interference proceeding involving the following issue:

"A metallic bottle-sealing cap having its lower edge adapted to be pressed into contact with a locking shoulder, and provided above the said edge with a circumferential, outwardly projecting rib or bead for engagement by the removing tool."

There were three parties to the original proceeding, Alfred L. Bernardin, William H. Northall, and William Painter.

The primary examiner awarded priority of invention to Northall and upon appeal to the examiners-in-chief the decision was affirmed. The appeal was then taken to the Commissioner, who reversed the examiners and awarded priority to Bernardin. Northall alone has appealed from that decision, and the claim of Painter is therefore no longer matter of consideration.

Applications for patents were filed by the parties in the following order of time: Bernardin, July 21, 1892; Painter, January 16, 1893; Northall, March 31, 1893.

The record contains a great mass of conflicting evidence, from which we are to determine who is entitled to priority, or rather, as between the two parties left to the controversy, who is the inventor, for one thing which is very plain from the record is that, as between Bernardin and Northall, this is not a case of two independent inventors who, working in ignorance of each other's discoveries, have exploited the same idea.

Bernardin claims to have conceived the idea in February, 1892. He was then and had for some years been the president of the Bernardin Bottle Cap Co.

In and before 1891 this corporation, whose place of business wa Evansville, Indiana, had been engaged in the manufacture of bottle sealing devices, the leading one of which consisted of a tin cap fo the mouth of the bottle, with a collar which fastened about its nec and was connected by strips with the cap. In February, 1892 Bernardin learned of a cap manufactured in Baltimore that wa made in a single piece and was much simpler than the one mad by his company.

This was made to press down about the shoulder or rim of th bottle neck and its edges were corrugated so as to make a projectin edge or flange for its easy removal.

This discovery alarmed Bernardin, and he began to consider im provements that might be made in such devices. There is no doubt that he considered two of these seriously and went to Wash-
30 ington to apply for patents about April 16, 1892. One was a cap with corrugated edges, which were to fit similar corrugations in a bottle made for the purpose, and the other was made with perforations in which a tool could be inserted for removal. He was informed by his attorneys that these devices were probably not patentable. They were also expensive to make and did not sufficiently overcome the difficulty of removal. He was very much discouraged and returned home. The great object in view was a cap, inexpensive to make, that would be a perfect seal and at the same time easily removable without injury to the bottle.

Bernardin claims that he had also conceived the idea of the cap in issue, with the bead or rim at the top, in February, 1892, and had discussed it, as well as the others, with Northall, who was the superintendent of the machine shop of the bottle cap company. He says that he made a rough sketch of the one with the bead, and that Northall preferred it to the others, but he (Bernardin) thought it would be too expensive to make. When he returned discouraged the matter was taken up again, and he suggested to Northall a simpler way of pressing on the bead or rim and directed him to make tools for the experiment. Proving satisfactory, he had some of the caps made and went to Washington in July, 1892, and filed his application for a patent.

Northall was a skilled mechanic and had been in the service of the bottle cap company for about eight years.

He claims that the idea of making a cap with a bead was suggested to him by the rim found on metallic cartridges and was matured on December 19, 1891, on which day he made a drawing of the same, with a tool to be used in removing it, and disclosed it to a number of persons.

He admits that he knew of the two devices of Bernardin before referred to and of his trip to Washington concerning patents for them, and says that before Bernardin's return he, having no confidence in the efficacy of those inventions, mentioned his own invention of the cap in issue to a fellow-workman and to the treasurer of the Bernardin Company. These persons say that he did so, but that he referred to his invention as having been made the night before. He also says that he showed his drawing to Bernardin on

his return, who was pleased with it and ordered the caps to be made and tested, but afterwards informed him it was not patentable. In part explanation of his conduct in taking no steps himself to apply for a patent, he claims to have been too poor to undertake it and to have been willing for the Bernardin Company to do so, expecting, however, to have an interest in it. He says that he was dependent upon his position with the company, which paid him $100 per month, and let the matter proceed until some time in August, 1892, when he saw from copies of papers in the Patent Office, shown him by Bernardin, that the application was made in the latter's name. He undertakes to explain his subsequent inaction by the fear he had of losing his place, by his ignorance of the law in such matters, which caused him to think that he was too late, and
31 to some slight extent by hopes that he would be given an interest in the new corporation forming and formed to exploit the invention.

There are, too, some other circumstances growing out of his connection with the Crown Cork and Seal Co. of Baltimore, assignee of Painter, and also holder of an option upon his (Northall's) claim herein, in the event of his success, that tend in some degree to affect the integrity of his claim.

On the other hand, Bernardin's conduct is surrounded by some circumstances that tend to impair the strength and weight of his claim, notwithstanding the diligence with which he has prosecuted it since April, 1892.

According to his own statement he made no disclosure of his invention of the disputed cap to any one except Northall until his return from Washington, about the last of April, 1892. It seems clear that he did not mention it to his Washington attorneys, Munn & Co., when they discouraged him as regards the patentability of the first two devices on which he filed applications. He has produced no sketch or drawing made prior to the application for patent.

He undertakes to account for the neglect of this invention by saying that he had deemed it impracticable because of the difficulty and expense that he apprehended in making the bead or rim.

There is an irreconcilable conflict between the statements of Bernardin on one side and Northall on the other. Fortunately it is not necessary to analyze these, weighing circumstance against circumstance and setting off inference against inference, in order to determine which of them is most entitled to belief.

In our opinion the case must turn upon the truth of falsity of Northall's statement that he made the drawing, which fully discloses this invention, on December 19, 1891.

If he made the drawing on that date he is the inventor. He has produced a piece of paper with the drawing on it, with that date written upon it with a pencil.

He says that, having been at work on the invention for some time, he completed his plan and made the drawing on that day, which was Saturday; that he went to the saloon of Frank Haas after supper and engaged with several acquaintances in a game of cards,

as he had often done before; that he lost each game and his companions began to make sport of him, saying that he had lost his skill through having neglected the game so long; that he said he had been working at a thing that would make him rich, and asked for a piece of paper to show them what he had been doing while absent. There was no paper, but some one handed him a cardboard "oyster sign" which Haas had over his lunch counter, and, turning it over, he made a rough sketch on the back of his bottle cap and tool for removing it.

This statement is corroborated by Frank Haas, the saloon-keeper; McDowell and Ziegler, draymen; Heidt, a school janitor; Oslage, a grocer, and Wagner, a horseshoer, who were all present. These witnesses are all positive that it occurred on Saturday night before Christmas, December 19, 1891, and account reasonably for
32 their ability to fix the precise date. Haas said that he put the sign away at the end of the oyster season and found and produced it after the controversy arose.

These witnesses appear to be intelligent laboring and business men and to have no pecuniary interest in the result of the controversy. They had lived long in Evansville, were well known, and no witness was offered to impeach their credibility.

They have either spoken the truth or been guilty of wilful falsehood; there is no room for mistake.

Again, Northall is corroborated by two other intelligent, disinterested, and apparently truthful witnesses. Henry B. Polsdorfer, who is a manufacturer of washboards, woodenware, etc., and a trained mechanic, says that he knew Northall well, and that they and their wives were intimate friends. Being interested in machinery and inventions, he frequently conversed with Northall upon such subjects.

He says that Northall showed him his drawing of the bottle cap in issue at his house, in Evansville, and explained it fully "between the middle and latter part of December, 1891." He recognized the drawing when produced, and remembered that it had December on it, but did not remember the day of that month. Mary E. Polsdorfer testified to hearing the conversation and seeing the drawing also. She remembered that it was just before Christmas, because she had gone to Mrs. Northall's to join her in making some slipper cases for presents and her husband had gone with her. We find no reasonable ground for supposing that any of the foregoing witnesses have confounded the Christmas of 1892 with that of 1891, as suggested.

The only direct attempt to break the force of all this corroborating evidence is by the charge that the date of this important drawing has been changed. It is charged that the date as it now appears has been written over an erasure, and both the original and an enlarged photographic copy have been offered for inspection in support of the charge.

If it could be shown that this date has been tampered with, the fact would discredit Northall's whole case, and for that reason and because the decision of the Commissioner is founded largely in that belief we have given the original and copy as close and carefuly

scrutiny as possible with the aid of simple microscopes of considerable magnifying power.

No witnesses were called to inspect the writing and testify as to the results of the observation.

With the greatest distrust of our own capacity in the matter, we are, nevertheless, compelled to rely upon our own inspection and to form our own opinion unaided.

That the drawing and the date both may have been traced over erasures of other things is not at all improbable. There was some conflict between Bernardin and Northall in regard to the time and place that the drawing paper itself had been obtained. Northall testified, without reference to this charge, which had not then been made or intimated, that the drawing was made on a piece cut from a sheet of old paper that he had brought with him to Evans-
33 ville from his eastern home and had had sketches on it which he "rubbed out" before putting this one on.

A pencil-mark is pointed out just beneath (that is, a little lower down the page) a letter in the word December, which the Commissioner thought was "the lower loop of a letter." This loop is plainly visible to the naked eye; in fact, it appears even fresher than the writing above it and shows no sign of attempt at erasure. If it be part of an erasure made for the purpose of falsifying the date, it seems strange that it should have been left when such great care was had in the complete erasure of the remainder.

Conjecture founded on a circumstance of that kind is not sufficient to discredit the testimony of positive witnesses.

Our attention was called, on the argument, to another alleged indication of fraudulent alteration of the date which seems not to have been suggested to the examiners or the Commissioner. It is claimed that the photographic copy discloses the figure 3 in proximity to the 1 in 1891 of the date. Our conclusion is, after examination, that this also is a mistaken conjecture. What would be the result, however, if it be conceded that there is the tracing of the figure 3 as claimed? The conjecture that the original date was 1893 instead of 1891 is inconsistent with all the established facts of the case and unreasonable in any view that may be taken of Northall's conduct.

If Northall did not invent the cap as claimed, he must have conceived the idea of claiming Bernardin's invention as his own as early as April, 1892. The caps were first made soon after that date, and Northall had notice of Bernardin's application for the patent as early as the summer of 1892. The invention was subject of local newspaper comment in September, 1892.

Now, if he prepared the drawing as part of his plan to defraud Bernardin, he surely would not have given it a date in the year 1893 or any other later than February, 1892, when, according to Bernardin, the knowledge of the invention was first communicated to him. Preparing it to antedate Bernardin, he would naturally have assigned his pretended invention to the year 1891. A change in the month of that year might have became important, but not so with the year.

After much consideration we can come to no other conclusion than that the appellant Northall is entitled to priority.

The decision appealed from will therefore be reversed and the proceedings and decision certified to the Commissioner of the Patent Office as provided by law. It is so ordered.

(Signed) SETH SHEPARD,
Associate Justice.

34 *Answer to Petition for Writ of Mandamus.*

Filed June 25, 1896.

U. S. Patent Office.

In the Supreme Court of the District of Columbia.

U. S. *ex Rel.* ALFRED L. BERNARDIN
v.
JOHN S. SEYMOUR, Commissioner of Patents, Respondent. } At Law. No. 40029.

Answer for respondent.

And now comes S. T. Fisher, acting Commissioner of Patents, and makes return officially to the order of the Honorable Louis E. McComas, justice of the supreme court of the District of Columbia, made on the 11th day of June, 1896, in the above-entitled action against John S. Seymour, Commissioner of Patents, to show cause why a writ of mandamus shall not issue, commanding the said John S. Seymour, Commissioner of Patents, to issue letters patent to the relator, as prayed for in the petition upon which said order was granted, and says—

That it is true, as stated by the petition, that the relator did file in the U. S. Patent Office on July 21, 1892, an application for a patent—serial No. 440,790—for improvement in metal bottle-sealing devices; that after examination the relator was adjudged entitled to letters patent for his invention, and his application was allowed and passed to issue October 15, 1892; that on February 10, 1893, said application was withdrawn from issue, and on February 24, 1893, an interference was declared with an application of one William Painter; that on March 31, 1893, William H. Northall filed an application—serial No., 468,524—for letters patent for the same invention, which application was added to the interference between Bernardin and Painter; that this interference was duly tried before the examiner of interferences, as provided by the statutes and the rules of practice of the Patent Office; that the examiner of interferences decided that the said William H. Northall was the original and first inventor of the improvement in controversy, and that the said Northall was entitled to a patent; that the relator then appealed to the examiners-in-chief of the Patent Office, and that the decision of the examiner of interferences was affirmed by them; that the relator then appealed to the Commissioner of

Patents, who, on March 23, 1895, reversed the decision of the examiners-in-chief and decided that Alfred L. Bernardin was the first and original inventor of the invention in controversy and was entitled to letters patent therefor, as appears by the copy of the decision annexed and marked "A."

It is further stated that it is true that on April 9, 1895, the said William H. Northall prosecuted an appeal to the Court of Appeals of the District of Columbia, according to the provisions of the acts approved February 9, 1893, and July 30, 1894, and the rules and regulations of said court; a copy of this appeal is annexed and marked "B;" that after the appeal was duly heard by the Court of Appeals the said court found that the said William H. Northall was the first and original inventor of the improvement in controversy, and by the decision dated January 6, 1896, reversed the decision of the Commissioner of Patents; that a certified copy of said decision of the said court was filed with the Commissioner of Patents, a copy of which decision is annexed and marked "C."

It is further stated that on January 22, 1896, Alfred L. Bernardin, the relator, did make a motion before the Commissioner of Patents to reopen the case for the admission of newly discovered evidence, as shown by a copy of said motion hereto attached and marked "D;" that on May 25, 1896, the Commissioner of Patents rendered a decision denying said motion; a copy of this decision is attached to this answer and marked "E."

It is further stated that on May 28, 1896, Alfred L. Bernardin, the relator, filed in the Patent Office a motion to stay the issue of a patent to Northall, pending proceedings by bill in equity to be filed in the circuit court of the United States for the district of Indiana; that a copy of this motion is attached and marked "F;" that this motion was heard by the acting Commissioner of Patents, and that the said acting Commissioner rendered a decision on June 12, 1896, denying said motion; a copy of this decision is attached to this answer and marked "G."

It is further stated that on May 28, 1896, the relator, as authorized by section 4915 of the Revised Statutes, filed in the circuit court of the United States for the district of Indiana a bill in equity against William H. Northall and John S. Seymour, Commissioner of Patents, to authorize the Commissioner to issue a patent to Alfred L. Bernardin, and that a copy of this bill is hereto attached and marked "H."

It is further stated that it is true that on June 11, 1896, the relator did tender the final Government fee of twenty dollars, with a request that said patent should issue to him, as shown by a copy of the request annexed and marked "I;" that the acting Commissioner of Patents did, on June 15, 1896, refuse the tender of the fee and did deny the request to issue the patent to the relator, as shown by the annexed copy of the decision, marked "J."

It is further stated that the decision of the Commissioner of Patents on the question of priority has not been reversed by him or any one acting for him; that the acting Commissioner refused the

fee and refused to issue the patent to the relator, not because he desired to make inquiry as to whether Alfred L. Bernardin is entitled to a patent or to be advised in that matter, but that he based his refusal to accept the fee and issue the patent, and does so still, solely upon the ground that the Court of Appeals of the District of Columbia has entertained the appeal taken to it from the decision of the Commissioner of Patents and found that William H. Northall was the first and original inventor and had entered a decision reversing the decision of the Commissioner of Patents in favor of Bernardin.

36 It is further stated that whether or not the act approved February 9, 1893, conferring jurisdiction upon the Court of Appeals of the District of Columbia to hear and decide appeals on error prosecuted from the decisions of the Commissioner of Patents, an officer of the executive department of the Government, is constitutional, the Commissioner or acting Commissioner is not advised.

It is further stated that if the decision of the Commissioner of Patents, which is that Alfred L. Bernardin, the relator, is the first and original inventor of the invention in controversy and is entitled to receive a patent as prayed for, is final, and if upon such decision it is the lawful duty of the Commissioner or the acting Commissioner of Patents to accept the final fee and issue a patent to Bernardin as prayed, then the acting Commissioner of Patents has improperly refused to accept the fee and to prepare said patent for issue, but if the decision of the Commissioner of Patents is subject to revision and reversal on appeal to the Court of Appeals of the District of Columbia, then such refusal on the part of the acting Commissioner of Patents to accept the final fee and issue the patent to Bernardin, the relator, is right and proper.

And, having fully answered, he prays judgment.

S. T. FISHER,
Acting Commissioner of Patents.

W. A. MAGRATH, *Of Counsel.*

EXHIBIT "A."

Filed June 25, 1896.

No. 15992. U. S. Patent Office. M. H.

NORTHALL
v.
PAINTER
v.
BERNARDIN. } Bottle-sealing Device.

Appeal from examiners-in-chief.

Application of Wm. H. Northall filed March 31, 1893, No. 468,524.

Application of Wm. Painter filed January 16, 1893, No. 458,549.

Application of Alfred L. Bernardin filed July 21, 1892, No. 440,790.

Mr. Wm. H. Gudgel for Northall.

Mr. Wm. C. Wood for Painter.

Messrs. Butterworth & Dowell for Bernardin.

In this case Painter and Bernardin appeal from the decision of the examiners-in-chief awarding priority of invention to Northall on the following issue:

"A metallic bottle-sealing cap, having its lower edge adapted to be pressed into contact with a locking shoulder, and provided above the said edge with a circumferential outwardly projecting rib or head for engagement by the removing tool."

37 In 1891 the Bernardin Bottle Cap Company was engaged in the manufacture of bottle-sealing devices of tin, differing from that of this issue, one form consisting of a collar about the neck of the bottle and a tin cap covering the top, the tin top and the collar being connected by tin strips. Bernardin was the principle owner and managing officer of the company, and Northall was foreman of the tool-room and worked under Bernardin's direction.

Painter has no connection with this company, but was connected with the Crown Cork & Seal Company of Baltimore, Maryland. In the view I take of this case he cannot prevail, by reason of his delays and inactivity for a year, between his alleged conception and his application, and his appeal is therefore dismissed.

The cap which the Bernardin Company was then manufacturing was unsatisfactory, and in the latter part of February Bernardin learned that a better and simpler device had been put on the market by the Crown Cork & Seal Company. This was regarded as a matter of great business consequence to the Bernardin Company. Early in the year the company talked about going into the tinware business, and Charles Hart, of Brooklyn, was engaged to inform the company what kind of presses and tools were required for that purpose. Northall thought that this might lead to his separation from

the company, for he knew little about the tinware business, and the new Baltimore device tended to the same thing.

Bernardin at that time was closely considering a corrugated bottle head and also a perforated bottle cap, and on April 16, 1892, he filed an application in the Patent Office covering such a device of his own invention. On that day he was in Washington upon the business of his application. While there he ascertained from his attorneys that the application for the corrugated bottle head and for the perforated cap was not allowable. Moreover, it was too hard to get the bottle cap off and too expensive to make. He was very much discouraged. Upon his return to Evansville it became apparent that a new and better cap would have to be found or the bottle-sealing business of the company would have to be abandoned.

Soon afterward the construction of the bottle cap, which is the subject-matter of this interference, was begun by the Bernardin Company, and the question is whether Bernardin or Northall originated it. The facts derived from undisputed testimony will be considered first. After a conference between Bernardin and Northall, Bernardin directed Northall to make a roll and a tool for beading the caps, and this Northall did. About April 25, 1892, a few caps were made with these tools, a specimen like those of the first lot being Northall's Exhibit No. 7, and this cap embodies the issue and is a full reduction to practice, which inures to the benefit of Bernardin or Northall according as the question of originality is decided for the one or the other. Northall made the tools under the direction of Bernardin in the same manner as he made other tools under Bernardin's direction, without any suggestion from
38 Northall that the tools would be the means for manufacturing an article which the company would not have the right to make, or that the bottle cap when made would embody the invention of Northall.

In the latter part of April, 1892, some of the new caps were made by the use of the arbor and grooved wheel, Bernardin's Exhibits 8 and 11, with no arrangement suggested by either Northall or Bernardin that the inven ion so reduced to practice was one for which the company would be obliged to treat with one of its subordinates. Better tools, the combination die for pressing the bead on the caps, another method of manufacture, were made by Bernardin's direction, still without any treaty as to the right to make the article. Soon afterward Northall came to understand that Bernardin was preparing to apply for a patent upon this invention.

On July 21, 1892, Bernardin was in Washington again and there made application for a patent upon this article as an invention of his own. In August he received papers from his attorneys in Washington concerning his application in the Patent Office, including a black-print copy of his drawings, showing Bernardin's name signed as inventor, and these he showed to Northall. In October he received a letter from his attorneys in Washington, stating that his application had been allowed. This Northall saw.

In February, 1893, Northall, for the first time, consulted an at-

torney about his interests. In the same month his counsel opened correspondence with the attorney for the Crown Cork & Seal Company and indirectly with Painter.

Between the first and fourth of March, 1893, Bernardin was informed that an interference had been declared between himself and Painter, and on the tenth of March this was mentioned by Bernardin to Northall.

March 17, 1893, Bernardin, Haas, and others formed a company for exploiting the new invention. Soon afterward Bernardin learned that Northall was in correspondence, through attorneys, with his opponent, Painter. On March 29, 1893, Bernardin discharged Northall, stating to him that it was for that reason. On the same day Northall and his attorney started for Washington and immediately prepared and filed in the Patent Office his application.

From these undisputed facts I am strongly impelled toward the conclusion that Bernardin is the real inventor, because it is difficult to believe that events progressed, under the daily observation of Northall, to the point of commercial manufacture of this article in a factory in which Northall had no proprietary interest without an attempt at least to exact an agreement giving him recompense if he so much as thought himself the inventor and without an attempt to apply for a patent in his own name.

It is now necessary to weigh the conflicting testimony, and first on the question whether Northall ever said to Bernardin, "I ought to get a patent on this." I doubt it. Had he said so much he would have said more or done more. That did not protect his supposed rights nor meet the exigency of another manufacturing the device before his eyes, as though it were not his. My con-
39 clusion is that at no prior time to his discharge did Northall make to Bernardin any claim to — the originator of this invention.

Northall claims that he has shown that he was in possession of the mental conception of this device as early as December 19, 1891, and that on that day he made two sketches of the device, one upon drawing paper at his house, Northall's Exhibit No. 1, and the other upon a card-board oyster sign in Haas's saloon that evening. Exhibit No. 1 is dated December 19, 1891. Since throughout the period from December to April the bottle-sealing branch of the Bernardin Company's business was at a crisis in its affairs by reason of the impending competition of the company in Baltimore with a superior cap, as they believed, it is a striking circumstance, if true, that Northall was in possession of the complete remedy. The evidence upon this point is challenged, and accordingly it has been closely scrutinized. The drawings were made at some time and one of them was exhibited on some occasion in Haas's saloon. Northall, McDowall, F-ank Haas, Oslage, Heidt, Zeigler, and Wagner all saw it at one time, and that in Haas's saloon. But at what time? Singularly enough, each remembers that it was on the 19th of December, 1891; McDowell because he had a dispute with Haas and for a time did not go there; Frank Haas because he attended a funeral the next day; Oslage because Haas said he was going to

a funeral the next day; Heidt because it was the Saturday before Christmas; Zeigler states it to be just before Christmas, 1891, but does not show how he fixes the date, and Wagner does not state how he fixes the time. It appears that all of these persons were at this saloon on other Saturday nights before and after this occasion, and the particular meeting at which Northall drew the sketch is not connected with any event the date of which is fixed by anything more than arbitrary association of ideas. At best it is entitled to but little weight.

It is indisputable that the first caps were made in the latter part of April, 1892. The caps were not made from either of these drawings. There are indications that these drawings whenever exhibited, either in the saloon or on the occasion of the visit to Northall of Mr. and Mrs. Polsdorfer, were exhibited not earlier than the time of making of the first caps. Mary Polsdorfer, while stating that it was shown to her on a visit of herself and Henry Polsdorfer to Northall in the latter part of 1891, attempts to fix the date by the making of slipper cases for Christmas and before the birth of her child on February 23, 1892; but the families were intimate; she made many visits before and after that time, and the casual exhibition of the drawing by Northall to her husband might have been on the same evening the slipper cases were spoken of or equally well on any other. On cross-examination she states that Northall showed her a cap at the same time that he showed the drawing, though she afterward says it was only the drawing of the cap. If the drawing and the cap were shown her together, the visit could not have been in December, 1891, nor earlier than the latter part of April, 1892, for the caps were not made until April.

40 Heidt was at the meeting in Haas's saloon when Northall drew the sketch on the back of an oyster sign, and states that the meeting was on Saturday before Christmas, 1891, but also says that Northall had a cap in his pocket, and that the rest of the party were handling it, although he did not. If Northall had the cap at the meeting in the saloon the meeting was as late as April. Comparing critically Frank Haas's testimony and Oslage's, it would appear that the meeting at the saloon was much later than December. Finally the drawing, Northall's Exhibit No. 1, upon its face raises doubts, in that the date appears to be written over an erased word, the lower loop of a letter remaining between the parallel lines of the handle of the decapper.

The conflict of testimony upon the first conversation at the factory between Bernardin and Northall after Bernardin's return from Washington in April, 1892, separately considered, leaves the mind in great doubt as to exactly what was said. It is examined in vain for substance upon which to base a conclusion either that Northall communicated the idea to Bernardin or Bernardin to Northall. But reconciling the testimony where possible and constructing language and circumstance into a consistent whole, it is thought that Northall did not have the invention as claimed in December, 1891; that it was first referred to in a later conversation between Northall and Bernardin when Bernardin was considering

the corrugated and the perforated sealing cap; that the conception originated with Bernardin and was not original with Northall, but was communicated by Bernardin to Northall, although Northall was the first to communicate the idea to Thuman, probably during Bernardin's absence in April.

Weight must be given to the facts of manufacture without seeking the consent of Northall; the orderly application by Bernardin for a patent, not with undue haste nor with unusual delays, but conformably with the common experience; the absence of Northall's assertion of title for many months and until after his discharge, and the long delay in his application for a patent; these all concur in showing Bernardin to be the inventor and the first, and accordingly the judgment of priority is awarded to him and the decision of the examiners-in-chief is reversed.

The record in this case abounds in improper remarks, long statements touching the conduct of counsel and witnesses, imputations of fraud, perjury, bribery, and finally, by the introduction of Inkenbrandt's testimony, implication in the violent death of Ives, which are not proof and are not proper parts of the record. Most of the matter alluded to should have been expunged before printing and would have been excluded upon motion. Smith *v.* Elliott, 9 Blatch., 400, 407. The record in this case is very voluminous at best, unnecessarily so, from the method of examination adopted, but that the office should be burdened with the reading of additional
41 and wholly irrelevant discussion of other matter of the kind alluded to is intolerable, and the insertion of such things in the record cannot be too strongly condemned.

Decision reversed.

JOHN S. SEYMOUR,
Commissioner.

March 23, 1895.

EXHIBIT "B."

Filed June 25, 1896.

$25 applied.

United States Patent Office.

W. H. NORTHALL
vs.
WILLIAM PAINTER
vs.
ALFRED L. BERNARDIN.

Interference No. 15992. Bottle-sealing Device.

To the Hon. the Commissioner of Patents.

SIR: In matter above named I, William H. Northall, hereby pray an appeal to the United States Court of Appeals for the District of Columbia from your honor's decision of March 23rd, 1895, awarding priority of invention to Alfred L. Bernardin.

The following reasons for appealing are assigned:

That the Hon. Commissioner erred:

First. In finding said Bernardin to be the inventor of the improvement in bottle-sealing devices which is the subject of said interference, and in awarding priority to said Bernardin.

Second. In failing to find that said Northall was the original and first inventor of said improvement and entitled to the patent therefor, and to award priority to said Northall.

Third. In failing to find that said invention was made, exhibited, and described by said Northall prior to any alleged conception or invention thereof by said Bernardin.

Fourth. In failing to find that said invention was exhibited and described by said Northall to the witnesses Henry Polsdorfer, Mary Polsdorfer, Frank Haas, McDowell, Wagner, Zeigler, Heidt, and Oslage prior to any alleged conception thereof by said Bernardin, and also described by said Northall to the officers and employees of the Bernardin Bottle Cap Co. prior to any mention or suggestion thereof by said Bernardin, and also that the same was communicated to said Bernardin by said Northall, and that the evidence indicated that said Bernardin had no conception thereof until after it was so communicated to him by said Northall.

Fifth. In failing to find that said invention, having been first made and described by said Northall, was unjustly and fraudulently appropriated by said Bernardin, who was not the inventor thereof, and in failing to adjudge priority in favor of said Northall and to award him the patent for said invention.

42 Sixth. In finding that at no time prior to his discharge did Northall make to Bernardin any claim to be the originator of the said invention, whereas he should have found that Northall communicated the invention to Bernardin and to others connected with and representing the company as original with himself, and thereafter constantly treated and referred to it as his, and that neither Bernardin nor others disputed the fact that it originated with Northall until after the interference was declared and after his consultation with counsel revealed to Bernardin the necessity of making such claim.

Seventh. In finding that Northall made the tools for forming the bottle-sealing devices or caps under Bernardin's direction without any suggestion from Northall that the tools would be the means for manufacturing an article which the company would not have the right to make, or that the bottle-sealing devices when made would embody the invention of Northall, whereas he should have found that said invention was disclosed to said Bernardin as the invention of said Northall; that Bernardin was fully informed of Northall's claim of invention, and that he desired and expected to obtain a patent therefor.

Eighth. In finding that there was no suggestion by said Northall that the invention was one for which the company would be obliged to treat with its subordinate, whereas he should have found that Northall repeatedly asserted his right as inventor and his desire and intention to obtain a patent therefor, and, among others, to said Bernardin and other officers and agents of said Bernardin Bottle Cap Co.

Ninth. In failing to find that the patent that Northall understood Bernardin was preparing to apply for was to be, as it should have been, in the name of Northall as inventor.

Tenth. In finding that said Northall made no attempt to exact an agreement for recompense or to obtain a patent in his own name while the invention was advancing to the point of commercial manufacture.

Eleventh. In failing to find that said Bernardin represented to said Northall, prior to the allowance of said Bernardin application, that said improvement was not patentable, and that he had ascertained that no patent could be obtained for said invention and discouraged Northall from applying therefor.

Twelfth. In finding that said Bernardin was the principal owner of the Bernardin Bottle Cap Co., and that Northall worked under his direction, whereas he should have found that said company was a corporation, in which said Bernardin was only a stockholder and an officer.

Thirteenth. In finding that all the persons who saw the making of the drawing at the Haas saloon were there on other Saturday nights after the occasion described.

Fourteenth. In finding that the time of the meeting at which Northall made said drawing in said saloon is not fixed by anything more than arbitrary association of ideas, and that it is entitled to little weight.

43 Fifteenth. In finding that there are indications that the Northall drawings in evidence were exhibited not earlier than the time of making the first caps, whereas he should have found that they were unmistakably shown to have been exhibited in December, 1891.

Sixteenth. In finding that said Northall did not have the invention as claimed in December, 1891, whereas he should have found that the said invention was made and disclosed by said Northall in December, 1891, and thereafter disclosed by said Northall to said Bernardin, as well as to others, prior to any conception or mention thereof by said Bernardin.

This appeal is taken under the act of Congress approved February 9th, 1893, section 9, providing for appeals to the United States Court of Appeals of the District of Columbia.

I pray that this appeal may act as a supersedeas, and that it shall stay the issue of letters patent to A. L. Bernardin, covering the subject-matter in controversy.

I further pray that a certified transcript of the record in this case will be furnished, and that the same may be certified to the Court of Appeals. I herewith tender the sum of twenty-five dollars on account of the costs of said transcript, and I will promptly respond to call for further funds should said amount be insufficient.

Very respectfully, WILLIAM H. NORTHALL,
By WM. H. GUDGEL, *Attorney.*

(Local address, care Mr. Howell Bartle, 639 F street N. W., Washington, D. C.)

April 6th, 1895.

EXHIBIT "C."

Filed June 25, 1896.

This is an appeal from the decision of the Commissioner of Patents in an interference proceeding involving the following issue:

"A metallic bottle-sealing cap having its lower edge adapted to be pressed into contact with a locking shoulder, and provided above the said edge with a circumferential, outwardly projecting rib or bead for engagement by the removing tool."

There were three parties to the original proceeding—Alfred L. Bernardin, William H. Northall, and William Painter.

The primary examiner awarded priority of invention to Northall, and upon appeal to the examiners-in-chief the decision was affirmed. The appeal was then taken to the Commissioner, who reversed the examiners and awarded priority to Bernardin. Northall alone has appealed from that decision, and the claim of Painter is therefore no longer matter of consideration.

Applications for patents were filed by the parties in the following order of time: Bernardin, July 21, 1892; Painter, January 16, 1893; Northall, March 31, 1893.

The record contains a great mass of conflicting evidence,
44 from which we are to determine who is entitled to priority; or, rather, as between the two parties left to the controversy, who is the inventor? For one thing, which is very plain from the record, is that, as between Bernardin and Northall, this is not a case of two independent inventors who, working in ignorance of each other's discoveries, have exploited the same idea.

Bernardin claims to have conceived the idea in February, 1892. He was then and had for some years been the president of the Bernardin Bottle Cap Co.

In and before 1891 this corporation, whose place of business was Evansville, Indiana, had been engaged in the manufacture of bottle-sealing devices, the leading one of which consisted of a tin cap for the mouth of the bottle, with a collar which fastened about its neck and was connected by strips with the cap. In February, 1892, Bernardin learned of a cap, manufactured in Baltimore, that was made in a single piece and was much simpler than the one made by his company.

This was made to press down about the shoulder or rim of the bottle neck, and its edges were corrugated, so as to make a projecting edge or flange for its easy removal.

This discovery alarmed Bernardin, and he began to consider improvements that might be made in such devices. There is no doubt that he considered two of these seriously, and went to Washington to apply for patents about April 16, 1892. One was a cap with corrugated edges, which were to fit similar corrugations in a bottle made for the purpose, and the other was made with perforations in which a tool could be inserted for removal. He was informed by his attorneys that these devices were probably not patentable.

They were also expensive to make and did not sufficiently overcome the difficulty of removal. He was very much discouraged and returned home. The great object in view was a cap, inexpensive to make, that would be a perfect seal and at the same time easily removable without injury to the bottle.

Bernardin claims that he had also conceived the idea of the cap in issue, with the bead or rim at the top, in February, 1892, and had discussed it, as well as the others, with Northall, who was the superintendent of the machine shop of the bottle cap company. He says that he made a rough sketch of the one with the bead, and that Northall preferred it to the others, but he (Bernardin) thought it would be too expensive to make. When he returned discouraged the matter was taken up again, and he suggested to Northall a simpler way of pressing on the bead or rim and directed him to make tools for the experiment. Proving satisfactory, he had some of the caps made and went to Washington in July, 1892, and filed his application for a patent.

Northall was a skilled mechanic and had been in the service of the bottle cap company for about eight years.

He claims that the idea of making a cap with a bead was suggested to him by the rim found on metallic cartridges and was matured on December 19, 1891, on which day he made a drawing of the same, with a tool to be used in removing it, and disclosed it to a number of persons.

He admits that he knew of the two devices of Bernardin before referred to and of his trip to Washington concerning patents for them, and says that before Bernardin's return he, having no confidence in the efficacy of those inventions, mentioned his own invention of the cap in issue to a fellow-workman and to the treasurer of the Bernardin Company. These persons say that he did so, but that he referred to his invention as having been made the night before. He also says that he showed his drawing to Bernardin on his return, who was pleased with it and ordered the caps to be made and tested, but afterwards informed him it was not patentable. In part explanation of his conduct in taking no steps himself to apply for a patent, he claims to have been too poor to undertake it and to have been willing for the Bernardin Company to do so, expecting, however, to have an interest in it. He says that he was dependent upon his position with the company, which paid him $100 per month, and let the matter proceed until some time in August, 1892, when he saw from copies of papers in the Patent Office, shown him by Bernardin, that the application was made in the latter's name. He undertakes to explain his subsequent inaction by the fear he had of losing his place, by his ignorance of the law in such matters, which caused him to think that he was too late, and, to some slight extent, by hopes that he would be given an interest in the new corporation forming and formed to exploit the invention.

There are, too, some other circumstances growing out of his connection with the Crown Cork and Seal Co. of Baltimore, assignee of Painter, and also holder of an option upon his (Northall's) claim

herein, in the event of his success, that tend in some degree to affect the integrity of his claim.

On the other hand, Bernardin's conduct is surrounded by some circumstances that tend to impair the strength and weight of his claim, notwithstanding the diligence with which he has prosecuted it since April, 1892.

According to his own statement, he made no disclosure of his invention of the disputed cap to any one except Northall until his return from Washington, about the last of April, 1892. It seems clear that he did not mention it to his Washington attorneys, Munn & Co., when they discouraged him as regards the patentability of the first two devices on which he filed applications. He has produced no sketch or drawing made prior to the application for patent.

He undertakes to account for the neglect of this invention by saying that he had deemed it impracticable because of the difficulty and expense that he apprehended in making the bead or rim.

There is an irreconcilable conflict between the statements of Bernardin on one side and of Northall on the other. Fortunately it is not necessary to analyze these, weighing circumstance against circumstance and setting off inference against inference, in order to determine which of them is most entitled to belief.

46 In our opinion the case must turn upon the truth or falsity of Northall's statement that he made the drawing which fully discloses this invention on December 19, 1891.

If he made the drawing on that date, he is the inventor. He has produced a piece of paper with the drawing on it, with that date written upon it with a pencil.

He says that, having been at work on the invention for some time, he completed his plan and made the drawing on that day, which was Saturday; that he went to the saloon of Frank Haas after supper and engaged with several acquaintances in a game of cards, as he had often done before; that he lost the game, and his companions began to make sport of him, saying that he had lost his skill through having neglected the game so long; that he said he had been working at a thing that would make him rich, and asked for a piece of paper to show them what he had been doing while absent. There was no paper, but some one handed him a card-board "oyster sign" which Haas had over his lunch counter, and, turning it over, he made a rough sketch on the back of his bottle cap and tool for removing it.

This statement is corroborated by Frank Haas, the saloon-keeper; McDowell and Zeigler, draymen; Heidt, a school janitor; Oslage, a grocer, and Wagner, a horseshoer, who were all present. These witnesses are all positive that it occurred on Saturday night before Christmas—December 19, 1891—and account reasonably for their ability to fix the precise date. Haas said that he put the sign away at the end of the oyster season, and found and produced it after the controversy arose.

These witnesses appear to be intelligent laboring and business men and to have no pecuniary interest in the result of the contro

est. They had lived long in Evansville, were well known, and no witness was offered to impeach their credibility.

They have either spoken the truth or been guilty of wilful falsehood. There is no room for mistake.

Again, Northall is corroborated by a positive, intelligent, disinterested, and apparently truthful witness. Henry L. Polsdorfer, who is a manufacturer of washboards, woodenware, etc., and a trained mechanic, says that he knew Northall well, and that they and their wives were intimate friends. Being interested in machinery and inventions, he frequently conversed with Northall upon such subjects.

He says that Northall showed him his drawing of the bottle cap in issue at his house in Evansville and explained it fully "between the middle and latter part of December, 1891." He recognized the drawing when produced, and remembered that it had December on it, but did not remember the day of the month. Mary E. Polsdorfer testified to hearing the conversation and seeing the drawing also. She remembered that it was just before Christmas, because she had gone to Mrs. Northall's to join her in making some slipper cases for presents and her husband had gone with her. We find no reasonable ground for supposing that any of the foregoing
47 witnesses have confounded the Christmas of 1892 with that of 1891, as suggested.

The only direct attempt to break the force of all this corroborating evidence is by the charge that the date of this important drawing has been changed. It is charged that the date, as it now appears, has been written over an erasure, and both the original and an enlarged photographic copy have been offered for inspection in support of the charge.

If it could be shown that this date has been tampered with the fact would discredit Northall's whole case, and for that reason and because the decision of the Commissioner is founded largely on that claim, we have gone over the original and copy as closely and carefully as possible with the aid of simple microscopes of considerable magnifying power.

No witnesses were called to inspect the writings and testify as to the results of the observation.

With the greatest distrust of our own capacity in the matter, we are, nevertheless, compelled to rely upon our own inspection and to form our own opinion unaided.

That the drawing and the date both may have been traced over erasures of other things is not at all improbable. There was some conflict between Bernardin and Northall in regard to the time and place that the drawing paper itself had been obtained. Northall testified, without reference to this charge, which had not then been made or intimated, that the drawing was made on a piece cut from a sheet of old paper that he had brought with him to Evansville from his eastern home, and had had sketches on it which he "rubbed out" before putting this one on.

A pencil-mark is pointed out just beneath (that is, a little lower down the page) a letter in the word December, which the Commis-

sioner thought was "the lower loop of a letter." This loop is plainly visible to the naked eye; in fact, it appears even fresher than the writing above it and shows no sign of attempted erasure. If it [illegible]

Conjecture founded on a circumstance of that kind is not sufficient to discredit the testimony of positive witnesses.

Our attention was called on the argument to another alleged indication of fraudulent alteration of the date which seems not to have been suggested to the examiners or the Commissioner. It is claimed that the photographic copy discloses the figure 3 in proximity to the one in 1891 of the date. Our conclusion is after examination that this also is a mistaken conjecture. What would be the result, however, if it be conceded that there is the tracing of the figure 3 as claimed? The conjecture that the original date was 1893 instead of 1891 is inconsistent with all the established facts of the case and unreasonable in any view that may be taken of Northall's conduct.

If Northall did not invent the cap, as claimed, he must have conceived the idea of claiming Bernardin's invention as his own
48 as early as April, 1892. The caps were first made soon after that date and Northall had notice of Bernardin's application for the patent as early as the summer of 1892. The invention was subject of local newspaper comment in September, 1892.

Now, if he prepared the drawing, as part of his plan to defraud Bernardin, he surely would not give it a date in the year 1893 or any other later than February, 1892, when, according to Bernardin, the knowledge of the invention was first communicated to him. Preparing it to antedate Bernardin, he would naturally have assigned his pretended invention to the year 1891. A change in the month of that year might have become important, but not so with the year. After much consideration we can come to no other conclusion than that the appellant Northall is entitled to priority.

The decision appealed from will therefore be reversed, and the proceedings and decision certified to the Commissioner of the Patent Office as provided by law. It is so ordered.

SETH SHEPARD,
Associate Justice.

Endorsed: Patent appeal No. 31. William H. Northall, appellant, *vs.* Alfred L. Bernardin. Opinion. Court of Appeals, District of Columbia. Filed Jan. 6, 1896. Robert Willett, clerk.

Court of Appeals of the District of Columbia.

I, Robert Willett, clerk of the Court of Appeals of the District of Columbia, do hereby certify that the foregoing is a true copy of the opinion of said Court of Appeals delivered on the 6th day of January, 1896, in the case of William H. Northall, appellant, *vs.* William Painter and Alfred L. Bernardin, No. 31 patent appeals, Jan'y

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Court of Appeals of the District of Columbia,
January Term, 1896.

t,
WILLIAM H. NORTHALL, Appellan } No. 31.
vs. NARDIN.
WILLIAM PAINTER and ALFRED L. BE
. No. 15992.

Subject-matter: Bottle-sealing device

Patents.

Appeal from the Commissioner o

cript of record from
This cause came on to be heard on the tran y counsel.
the Commissioner of Patents and was argued ere ordered and ad-
On consideration whereof it is now of the said Commis-
49 judged by this court that the decision the same is hereby,
sioner of Patents in this cause be, and
reversed.

STICE SHEPARD.

Per MR. J

January 6, 1896.

(A true copy.)
Test:
WILLETT, *Clerk.*
[COURT SEAL.]

EXHIBIT "D"

Filed June 25, 1896.

Office.

In the United States Patent

NORTHALL
vs.
PAINTER
vs.
BERNARDIN.
} Interference No. 15992. Bot

tle-sealing Device.

To the Commissioner of Patents:

by his attorneys, But-

SIR: And now comes Alfred L. Bernardin,
terworth & Dowell, and moves:

be reopened for the

First. That the above-entitled interference ch could not with rea-
admission of newly discovered evidence whi e hearing, and that a
sonable diligence have been produced at th the contestant, A. L.
reasonable time be assigned within which f the several persons
Bernardin, may introduce the testimony o

whose affidavits are filed in support of this motion and of others for the purpose of establishing the facts recited in said affidavits, and such other evidence as may be competent to make clear the facts in that behalf and to show:

(1.) That the drawing introduced in evidence in this cause on behalf of William H. Northall as "Northall's first drawing, Exhibit No. 1," in support of his alleged claim to priority of invention, was not made at the date alleged in the testimony of said Northall and his witnesses, to wit, December 19, 1891, but at a date long subsequent thereto, and that the true date originally placed upon said drawing was erased by the said Northall and a fictitious date written over the erased date prior to offering the same in evidence, and for the purpose of concealing the date when said exhibit was actually made, and thereby misleading the Commissioner of Patents and the court.

(2.) That the alleged date of the making and exhibition at the saloon of Frank Haas of the drawing offered in evidence on behalf of the said Northall as "Northall's Exhibit No. 3, card-board drawing," is erroneous, and that such exhibition occurred, if at all, and such drawing was made long subsequent to December, 1891, and subsequent to the making of the bottle caps embodying the invention in issue, at the works of the Bernardin Bottle Cap Company, in April, 1892.

Second. That an order be entered authorizing the use as
50 evidence in this cause of so much of the testimony of William H. Northall and his witness Henry B. Polsdorfer, taken in the pending interference No. 17284, between said Northall and Bernardin, for bottle-capping machines, as may be competent to show the relations existing between the said Northall and Polsdorfer and the interest of the latter in the result of the pending interferences.

Third. That the issuance of a patent to the said William H. Northall, in whose favor decision has been rendered by the Court of Appeals, overruling the decision of the Commissioner of Patents, be stayed, and further action upon the application of the said Northall involved in this interference be suspended pending the final determination of this motion.

In support of this motion are herewith filed affidavits of Joseph B. Church, Edwin B. Hay, Millard F. Hatton, John J. Nolan, Ernest D. McAvoy, R. C. Rice.

Reference will also be made at the hearing upon this motion and in support thereof to such parts of the evidence comprised in the record of testimony and exhibits filed in this cause in behalf of the parties thereto as may be deemed competent and proper.

A. L. BERNARDIN,
By BUTTERWORTH AND DOWELL,
His Attorneys.

January 22nd, 1896.

EXHIBIT "E."

Filed June 25, 1896.

No. 15992. M. H.

U. S. Patent Office.

NORTHALL
v.
BERNARDIN. } Bottle-sealing Device.

Motion to reopen.

Application of William H. Northall filed March 31, 1893, No. 468,524.

Application of Alfred L. Bernardin filed July 21, 1892, No. 440,790.

Mr. Wm. H. Gudgel for Northall.

Messrs. Butterworth & Dowell for Bernardin.

After a decision in his favor by the office and a reversal of that decision by the Court of Appeals of the District of Columbia, Bernardin moves to reopen this case for the purpose of introducing newly discovered evidence which he claims will probably change the result. The most significant part of the alleged newly discovered evidence is that of a partly erased writing, over which the date December 19, 1891, was written upon Northall's drawing Exhibit No. 1. Upon this point the affidavit of Mr. Joseph B. Church
51 is presented to the effect that he deciphers the partly erased writing to be February, 1893. A photograph taken about the time the exhibit was put in evidence shows that there had been an erasure, and enlarged photographs taken later show parts of letters which cannot be deciphered from the drawing itself.

In answer to the affidavits of Bernardin upon this motion Northall makes an affidavit upon this point as follows:

"The paper upon which my original drawing was made was some that remained of what I was using for making sketches during the last two years I lived in Bridgeport, Connecticut. It had been used, and I erased what was on it before making this drawing.

"When I testified last fall in the machine interference about the 'loop' shown in the photograph of my drawing I thought it must be the upper part of a '*b*,' as I knew I wrote December twice the night I made the drawings. I could not account for any kind of a loop in any other way. I am sure that I never wrote any word on that paper having a letter with a lower loop after I made the drawing, unless I accidentally made a lower loop when I intended an upper one. I write but little and sometimes get letters wrong and have to change them, but I have no distinct recollection of having done so when dating this drawing, though it might have happened. I sometimes wrote dates and other words on the sketches which I made in Bridgeport."

The question is whether this evidence was discovered since the

former trial. The general principles regarding new trials for newly discovered evidence are that an application therefor is looked upon by the courts with disfavor; that the evidence must have been discovered since the former trial; that the party must have used due diligence in procuring it on the former trial; that it must be material to the issue; that it must go to the merits of the cause and not merely to impeach the character of a witness; that it must not be merely cumulative; that it must be such as ought to produce on another trial an opposite result on the merits.

The bearing of this evidence of something imperfectly erased is important. A working drawing of a bottle-capping device in the hands of either of these parties as early as December 19, 1891, is extremely significant; a working drawing in the hands of Northall as late as February, 1893, would be of no special significance.

It was claimed by Northall that the evidence was cumulative. It is true that there was evidence tending to show that Northall did not make a working drawing of this invention as early as December 19, 1891, in the record, strictly so called. That evidence is circumstantial. In the trial upon appeal before the circuit court of appeals of this District it appears that enlarged photographs were exhibited to the court for the purpose of showing that there had been an erasure, and the argument appears to have been made that December 19, 1891, was not the true date of the paper. It does not appear that any testimony was presented to that court or that there is any in the record to the point of what the erased word or figures are, unless the exhibit itself may be considered such testimony. There is presented before me an account of this matter by Northall
52 himself which is in the nature of an admission that what was erased was a date, and that he erased it, and that he wrote the words and figures above it—December 19, 1891.

It has been held that the admission of a party is not evidence of the same kind as the testimony of other witnesses, and therefore is not cumulative, although relating to the same controverted fact. Wayt *v.* Burlington, etc., R. Co., 45 Iowa, 217; Humphreys *v.* Klick, 49 Ind., 189; Rains *v.* Ballow, 54 Ind., 82; Fletcher *v.* People, 117 Ill., 190.

But the evidence tends to establish a fact that was not before in the case, to wit, that the drawing bore another date, and that the date it first bore was February, 1893. If this testimony is to be believed, and if it turn out to be, on more critical examination, of the tenor indicated, it appears to me to be destructive of Northall's case.

While impressed with this evidence, I deem it my duty, in view of the doubt whether the Commissioner has power to open a case after it has been considered and decided by the circuit court of appeals in this district on appeal, to disregard it and deny the motion. Were the petitioner without other remedy, I might take a different view of this case, but under section 4915 of the Revised Statutes he has a remedy by bill in equity, where, upon a record hereafter to be made, with a fuller knowledge of all the facts, it will

be adjudged whether he be entitled to the patent which must now be refused.

Without passing upon the other matters urged by Northall against this motion, the motion must be dismissed, and it is so ordered.

JOHN S. SEYMOUR,
Commissioner.

May 25, 1896.

EXHIBIT "F."

Filed June 25, 1896.

In the United States Patent Office.

WILLIAM H. NORTHALL
vs.
WILLIAM PAINTER
vs.
ALFRED L. BERNARDIN.

Interference No. 15992. Bottle-sealing Device.

Motion to Stay Proceedings.

To the Commissioner of Patents.

SIR: And now comes Alfred L. Bernardin, by his attorneys, Butterworth & Dowell, and moves that further proceedings in the above-entitled interference be suspended, and that the issuance of a patent to Northall be stayed pending proceedings by bill in equity and the decision of the court in the case of Alfred L. Bernardin *vs.* The Commissioner of Patents and William H. Northall, to be forthwith instituted in the circuit court of the United States for the
53 district of Indiana, pursuant to the provisions of section 4915 of the Revised Statutes.

In support of this motion I shall refer at the hearing before the Commissioner to the records of the proceedings in the interference, to the affidavits, photographs, &c., filed in support of my motion to reopen the interference, and to the decision of the Commissioner of Patents on said motion rendered May 25th, 1896, and also to a copy of the aforesaid bill in equity.

ALFRED L. BERNARDIN,
By BUTTERWORTH & DOWELL,
His Attorneys.

EXHIBIT "G."

Filed June 25, 1896.

Intf. No. 15992. S. E. T.

U. S. Patent Office.

NORTHALL
v.
BERNARDIN. } Bottle-sealing Device.

Motion.

Application of William H. Northall filed March 31, 1893, No. 468,524.

Application of Alfred L. Bernardin filed July 21, 1892, No. 440,790.

Mr. William H. Gudgel for Northall; Messrs. Butterworth & Dowell for Bernardin.

This is a motion by Bernardin "that further proceedings in the above-entitled interference be suspended, and that the issuance of a patent to Northall be stayed pending proceedings by bill in equity and the decision of the court in the case of Alfred L. Bernardin *vs.* The Commissioner of Patents and William H. Northall, to be forthwith instituted in the circuit court of the United States for the district of Indiana, pursuant to the provisions of section 4915 of the Revised Statutes."

The question as to whether the filing of a bill in equity by a defeated party to an interference should stay the issue of a patent to the successful party was fully discussed by the Secretary of the Interior in the decision in the case of *Ex parte* Sargent, 12 O. G., 475, C. D., 1877, 125, and was decided in the negative. The same conclusion was reached in the case of Wells *v.* Boyle, 43 O. G., 753, C. D., 1888, 36.

After a careful consideration of the question I am of the opinion that the practice indicated in said decisions should be followed.

The motion is therefore denied.

S. T. FISHER,
Acting Commissioner.

June 12, 1896.

54 Filed June 25, 1896. M. H.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., *June* 23, 1896.

In the Supreme Court of the District of Columbia.

U. S. *ex Rel.* ALFRED L. BERNARDIN
v.
JOHN S. SEYMOUR, Commissioner of Patents, Respondent.
} At Law. No. 40029.

It is stipulated by and between counsel that the annexed copy of the bill of complaint is a true copy of the bill in equity, No. 9358, filed in the circuit court of the United States for the district of Indiana, entitled Alfred L. Bernardin, complainant, *v.* William H. Northall and John S. Seymour, Commissioner of Patents, defendants, and that said copy may be used in the present suit of mandamus against John S. Seymour, Commissioner of Patents, in lieu of a certified copy, subject to correction if found incorrect.

W. A. MEGRATH,
Counsel for Commissioner of Patents.
BUTTERWORTH & DOWELL,
Counsel for Alfred L. Bernardin.

EXHIBIT "H."

Filed June 25, 1896.

In the Circuit Court of the United States for the District of Indiana.

ALFRED L. BERNARDIN, Complainant,
vs.
WILLIAM H. NORTHALL and JOHN S. SEYMOUR, Commissioner of Patents, Defendants.
} In Equity.

To the honorable the judges of the circuit court of the United States for the district of Indiana:

Alfred L. Bernardin, a citizen of the State of Indiana and residing at Evansville, in the county of Vanderburgh and State of Indiana, brings this his bill of complaint against William H. Northall, a citizen of said State, residing at Evansville aforesaid, and John S. Seymour, Commissioner of Patents, having his official residence at the city of Washington, in the District of Columbia.

1. And thereupon your orator complains and says that he, being the true, original, and sole inventor of a new and useful improvement in bottle-sealing devices known as the "beaded sealing cap" or beaded cap, which invention or improvement was not know- or used by others in this country and not patented or described in any printed publication in this or any foreign country before his invention or discovery thereof and which had not been in public use or

55 on sale in the United States for more than two years prior to his application for a patent therefor, on the 21st day of July, A. D. 1892, made application in due form of law to the Commissioner of Patents for letters patent for said invention and filed in the United States Patent Office a written description of the said invention and of the manner and process of making, constructing, and using the same in such full, clear, concise, and exact terms as to enable any persons skilled in the art or science to which it appertains or with which it *it* most nearly connected to make, construct, and use the same, explaining the principle thereof and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions, and particularly pointing out and distinctly claiming the part or improvement which he claims as his invention or discovery, as upon reference to said application or a duly authenticated copy thereof, here in court ready to be produced and shown unto your honors, will more fully appear, and to which your orator craves leave to refer.

II. And your orator further shows unto your honors that he conceived the aforesaid invention during the month of February, 1892, and disclosed it to the defendant William H. Northall a few days thereafter and during the month of March, 1892; that at and prior to the last-mentioned dates your orator was and still is the president, superintendent, and general manager of the Bernardin Bottle Cap Company of Evansville, Indiana, manufacturers of bottle caps constructed in accordance with patents theretofore issued to your orator as the inventor, and the said Northall was at that time and prior thereto and until the 29th of March, 1893, a trusted employé of said Bernardin Bottle Cap Company, working under the direction and supervision of your orator, and while so employed assisted as a mechanic in making the first beaded caps that were made embodying your orator's aforesaid invention, which caps were made during the month of April, 1892, under your orator's direction and supervision and as a reduction to practice of your orator's aforesaid invention.

III. And your orator further shows unto your honors that on due proceedings had in the Patent Office your orator was by an official letter dated October 15, 1892, notified by the Commissioner of Patents of the allowance of said application, reciting in said notice that six months from the date thereof would be allowed for the payment of the final Government fee, upon the payment of which the patent would issue to your orator; and the defendant, the said William H. Northall, was informed by your orator of the allowance of said application, the written notice of which he saw and read when it was received, on or about the 18th of October, 1892, but neither at that time nor at any other time in your orator's presence or to his knowledge until the doing of the acts hereinafter complained of did he make any claim that he, the said Northall, was the inventor, either in whole or in part, of said invention.

IV. And your orator further shows unto your honors that thereafter, to wit, on the 16th day of January, 1893, one William Painter, of Baltimore, Maryland, the secretary and business manager of the

Crown Cork & Seal Company of Baltimore, Maryland, having theretofore, through his agent, without your orator's knowl-
56 edge or consent, surreptitiously obtained one of your orator's aforesaid beaded sealing caps from the works of the Bernardin Bottle Cap Company, where your orator's experiments were being conducted, during the absence of your orator and his employés and when the works were closed, and having thus obtained said cap the said William Painter filed in the United States Patent Office an application for a patent for the same invention as that described and claimed in your orator's aforesaid application; and thereafter, to wit, on the 24th day of February, 1893, an interference was declared between your orator's aforesaid application and the application so filed by said William Painter for the purpose of determining the question of priority of invention in accordance with the provisions of the Revised Statutes and the rules of practice of the Patent Office.

V. And your orator further says that the said William L. Northall, as a trusted employé, receiving and having the confidence of your orator, was charged with the duty of preparing and did prepare drawings for making the tools and assisted in making said tools for the purpose and in manufacturing said sealing cap, and was fully informed of each step taken by your orator from the first conception of the invention, in February, 1892, until the same was reduced to practice, and on until a patent was applied for by your orator and *and* allowed by the honorable Commissioner of Patents.

VI. And your orator further says that after his said invention was completed and reduced to practice and he had applied for a patent therefor, which had been allowed, of all of which and with the details of which the said Northall had, as aforesaid, full knowledge, he, the said Northall, did, as your orator is informed and believes, and hence avers and charges, on or about the month of February, 1893, corruptly and with the intent and purpose of defrauding your orator and preventing him from obtaining his patent on said invention which he, the said Northall, knew had been allowed by the Commissioner of Patents, and with the purpose and intent to appropriate said invention in whole or in part to his own use or derive some pecuniary benefit therefrom, and for the purpose of carrying out and accomplishing said object and to despoil your orator of his said property in said invention, the said Northall, while he was still a trusted employé of your orator and sustained toward him confidential business relations as such employé, personally and by his agent and attorney entered into a secret and clandestine correspondence with a competitor of your *p*rator, revealing to said competitor or to his agent the secret and confidential business of your orator in reference to said invention, and, further, in carrying out said object and purpose said Northall on or about the first day of April, 1883, entered into an agreement with William C. Wood, of the city of Washington, District of Columbia, the agent of your orator's competitor, to wit, the Crown Cork & Seal Company of Baltimore, Maryland, by the terms of which agreement the said

competitor agreed and undertook to pay to the said Northall
57 fifty ($50.00) dollars a month for each and every month during the whole period he should be engaged in performing the service in said contract stipulated to be performed by the said Northall. By the terms of said contract, a copy of which is hereto attached and marked "Exhibit A" and made a part hereof for reference, the said Northall agreed and undertook to prevent your orator from obtaining his said patent and to secure for your orator's competitor, to wit, the Crown Cork and Seal Company of Baltimore, Maryland, the ownership and control of said invention; that the said William C. Wood, as agent for said Crown Cork & Seal Company, by the terms of said contract reserved to himself the power and authority to withhold and altogether withdraw said monthly stipend from the said Northall at any time if he failed to perform to the satisfaction of said Wood the service exacted of him by said Wood under the terms of said contract.

VII. And your orator further shows unto your honors that on the 31st day of March, 1893, the said William H. Northall filed in the United States Patent Office an application for a patent for the said invention, and on the 7th day of April, 1893, the said Northall was made a party to the aforesaid interference between your orator's application and the application of the said Painter.

VIII. And your orator further says that he is informed and believes, and hence avers, that in pursuance of said agreement and in promoting the object of said conspiracy the said Northall, in his aforesaid application, claimed that he was the original and first inventor of said beaded sealing cap, and thereupon he, the said Northall, did, as your orator is informed and believes, and hence avers and charges, fabricate testimony by erasing the date and inscription on a certain drawing which disclosed the invention and writing thereon another and different date so as to make it appear that said drawing was made at an earlier period than it actually was made, all of which was done to induce the belief that said drawing was made as of the date so fraudulently written on said drawing, when in truth and in fact it was made more than a year subsequent thereto.

IX. And your orator further says that he is informed and believes, and hence avers, that in promoting and carrying out the intent and purpose aforesaid the said William H. Northall prevailed upon certain witnesses to testify that certain drawings disclosing the said invention were made and exhibited to them and certain writing was placed thereon on a date earlier than the true one, the said Northall well knowing that the testimony of the said several witnesses in that behalf was incorrect and untrue.

X. And your orator further says that on the 23rd day of March, A. D. 1895, upon the pleadings and proofs taken and filed in the case, the Commissioner of Patents rendered a decision awarding priority of invention to your orator, Alfred L. Bernardin, as against the claims of both the said Painter and the said Northall, as by reference to said decision or a duly authenticated copy thereof here

in court ready to be produced and shown unto your honors
58 will more fully appear and to which your orator craves leave to refer, and in view of the Commissioner's decision against his alleged claim to the invention the said Painter dropped out of the interference, but said Northall, in carrying out his said agreement, took an appeal to the Court of Appeals of the District of Columbia, your orator's said competitor paying all bills and defraying all expenses incurred in and about that behalf, and said cause came on to be heard before the Court of Appeals on the 12th day of November, 1895, on the evidence produced before the Commissioner, said false and fraudulent drawings so as aforesaid fabricated being a part of the record and accepted by the court as true and genuine, and on the 6th day of January, 1896, the said court rendered a decision reversing the decision of the Commissioner of Patents for reasons recited in said decision, as by reference thereto or to a duly authenticated copy thereof here in court ready to be produced and shown unto your honors will more fully appear.

XI. And your orator further says that so skillfully made were the aforesaid erasures, alterations, and changes in the date and inscription upon the drawing and paper that neither your orator nor his counsel suspected or detected the same, and only learned of it after all the testimony in said interference case had been taken and filed and the case set for hearing and about to be heard by the Court of Appeals of the District of Columbia on appeal by the said Northall from the decision of the Commissioner of Patents awarding your orator to be the true and original inventor.

XII. And your orator further says that by reason of said false and fraudulent representations and skillful fabrication of testimony by the erasures and changes made upon said drawing and paper as aforesaid the said Court of Appeals of the District of Columbia was imposed upon and induced to believe that the dates so falsely fabricated were the original and correct dates, whereas they were and were well known to said Northall to be incorrect and untrue.

XIII. That by reason of such false and fraudulent testimony so as aforesaid fabricated the said Court of Appeals of the District of Columbia was imposed upon and misled and *were* induced to rely upon the genuineness and honesty of said false and fraudulent dates so as aforesaid fabricated and which were intended to indicate and induce the belief that said false and fraudulent date was that upon which said drawing was made, and therefore gave judgment reversing the decision of the Commissioner of Patents, who had awarded priority of invention to your orator.

XIV. And your orator further complains and says that he has invested and expended large sums of money in experimenting, developing, and reducing to practice his aforesaid invention and for the purpose of making the same commercially practicable and profitable to himself and of advantage to the public; that the invention is of great commercial utility and value; that its novelty, superiority, and value is generally recognized, yet the said Northall, well knowing the premises and the rights of your orator as aforesaid,

but contriving and conspiring to injure and deprive your orator of
the profits, benefits, and advantages which might and other-
59 wise would have accrued to him from said invention and the
letters patent to be issued thereon, set up, as aforesaid, an alleged claim to the invention for the purpose of an interference in the interest of the said Crown Cork & Seal Company, and said interference has been prosecuted at the expense of the said Crown Cork & Seal Company, as your orator is informed and believes, and hence alleges.

XV. That the said William H. Northall, as an employé of the Bernardin Bottle Cap Company, working under the direction and supervision of your orator and assisting in the work of making the beaded caps embodying your orator's invention, continued to receive your orator's confidence and friendship, and affecting an earnest desire to aid your orator in preparing drawings and tools to produce said beaded caps, and had full knowledge of your orator's acts and doings in the matter of experimenting and developing your orator's aforesaid invention until the 29th day of March, 1893, about which time your orator was informed that his theretofore trusted employé had been and was then engaged in clandestine correspondence with the Crown Cork & Seal Company or the agent of said company, competitors in business of the Bernardin Bottle Cap Company, with reference to your orator's said invention for the purpose of setting up a claim thereto and appearing in the interest of said claim to said company, whereupon the said Northall was discharged from the service of the company.

XVI. That the aforesaid acts and doings of the said defendant have caused and are causing your orator great injury and damage, and that notwithstanding the novelty and value and utility of your orator's invention he is wholly without protection and is being deprived of his rights in that behalf and is suffering irreparable loss and damage.

XVII. And your orator says that although the appeal hereinbefore mentioned, prosecuted by the said Northall from the decision of the Commissioner of Patents to the Court of Appeals of the District of Columbia, was in conformity to section 4915 of the Revised Statutes of the United States, authorizing and providing for such appeals, and the review and revision of the decision of the Commissioner of Patents in that behalf by the said Court of Appeals, yet your orator says that said court was without jurisdiction in that behalf to modify, reverse, revise, or annul the said decision of the Commissioner of Patents rendered in that behalf, the statute of the United States providing for such appeals and review to the contrary notwithstanding.

Your orator further says in that behalf that said court was wholly lacking in jurisdiction to hear and determine and revise or reverse the decision of the Commissioner of Patents, because all matters pertaining to the granting of patents by the United States to inventors and the determination of every question in that behalf is and at the same time and theretofore was conferred upon and by law belongs to the executive department of the Government, and

has been by law specially conferred upon the Bureau of Patents and the Commissioner of said bureau, which said bureau and the official head thereof form a part of the departmental organization and machinery of the executive department of the Government, and therefore an appeal from the official act in question being an official act of the executive department of the Government, acting within the jurisdiction properly conferred upon it under the Constitution of the United States, cannot be reviewed on appeal or writ of error prosecuted to the judicial department of the Government and reversed or nullified by a court of said judicial department.

And forasmuch as the said executive and judicial departments of the Government are separate, co-ordinate, coequal, and independent, said appeal for the purpose of review of said official action so, as aforesaid, prosecuted from the Commissioner of Patents to a judicial tribunal of the judicial department of the Government, to wit, to the Court of Appeals of the District of Columbia, is in contravention of policy of the Government and in violation of the Constitution of the United States, and hence the finding and decision of said court reversing the decision of the Commissioner of Patents rendered in that behalf is *coram non judice*, void, and of no effect; and your orator says that but for said action of the said Court of Appeals in form reversing the finding and decision of the honorable Commissioner of Patents adjudicating your orator's application for said invention, to which by the decision of said Commissioner your orator was entitled, would long since have been issued to him.

Wherefore your orator prays your honors to determine whether said writ of error so as aforesaid prosecuted was operative in law to reverse or annul the decision of the said Commissioner of Patents, and that such order and decree may be made in that behalf as may be just.

XVIII. And your orator further prays that this honorable court, on notice to the defendants, the said William H. Northall and the Commissioner of Patents, John S. Seymour, and other due proceedings had, may adjudge that your orator is entitled, according to law, to receive a patent for his said invention, as set forth in his aforesaid application and specified in the claim thereof, so that the said Commissioner of Patents, John S. Seymour, or his successors in office may be authorized to issue letters patent to your orator for said invention, in accordance with the decision of your honors, and for such other and further relief in the premises as the facts in the case may require and to your honors may seem meet.

And to this end may it please your honors to grant unto your orator the writ of subpœna *ad respondendum* issuing out of and under the seal of this court, directed to the defendant the said William H. Northall, commanding him on a certain day and under a certain penalty to be and appear in this honorable court, and then and there to answer the premises and to stand to and abide by such order and decree as may be made in this behalf, and also a writ of

subpœna of *respondendum*, directed to the said John S. Seymour, Commissioner of Patents, commanding him on a day
61 certain to appear and answer this bill of complaint.

And your orator will ever pray, &c.

(Signed) ALFRED L. BERNARDIN,
Complainant.

(Signed) BUTTERWORTH & DOWELL,
Solicitors and of Counsel.

U. S. OF AMERICA,
State of Indiana, County of Vanderburgh, } ss:

On the 26th day of May, A. D. 1896, before me personally appeared Alfred L. Bernardin, the above-named complainant, who, being duly sworn, deposes and says that he has read the foregoing bill of complaint subscribed by him and knows the contents thereof, and that the same is true of his own knowledge except as to the matters therein stated on information and belief, and as to those matters he believes it to be true.

ALFRED L. BERNARDIN,
Complainant.

Subscribed and sworn to before me this 28th day of May, A. D. 1896.

[SEAL.] NOBLE C. BUTLER, *Clerk.*

UNITED STATES OF AMERICA,
District of Indiana, } ss:

I, Noble C. Butler, clerk of the circuit court of the United States within and for the district aforesaid, do hereby certify that the above and foregoing is a full and true copy of the bill of complaint in the cause of Alfred L. Bernardin against William H. Northall *et al.*, filed in my office on the 28th day of May, 1896, as fully as the same remains upon the files now in my office.

Witness my hand and the seal of said court, at Indianapolis, in said district, this 28th day of May, A. D. 1896.

[Seal of the Court.]

NOBLE C. BUTLER, *Clerk.*

EXHIBIT "I."

Filed June 25, 1896.

WASHINGTON, D. C., June 10th, 1896.

Hon. Commissioner of Patents.

SIR: Herewith please find draft on New York for twenty ($20) dollars, payable to the order of the Commissioner of Patents, to be applied as the final Government fee upon my application for bottle-sealing devices, filed July 21, 1892—serial No. 440,706—and allowed October 13th, 1892. Said application having been withdrawn from

ater applications filed
H. Northall for the
having been decided
rch 23rd, 1895, in my
behalf complied with
al decision being that
rs patent, I herewith
tent which you have

ARDIN,
ND DOWELL,
His Attorneys.

n having been with-
nce, and said interfer-
ardin on appeal to the
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he request to issue a

ioner was favorable to
said decision having
eals of the District of
Northall, this office is

. FISHER,
Acting Commissioner.

e certified to as true
er of Patents.

t of Columbia.

NARDIN } At Law. No.
nts. } 40029.

he relator's petition for
t, and counsel having
consideration thereof,
red and adjudged that
d and the petition be,
ts of relator.
n appeal to the Court of
judgment of this court

dismissing the petition, the same is allowed, and bond is fixed in the penalty of two hundred dollars.

L. E. McCOMAS, *Justice.*

63 *Memorandum.*

July 2, 1896—Bond for appeal filed.

In the Supreme Court of the District of Columbia.

THE UNITED STATES *ex Rel.* ALFRED L. BERNARDIN *vs.* JOHN S. SEYMOUR, Commissioner of Patents. } At Law. No. 40029.

The President of the United States to John S. Seymour, Commissioner of Patents, Greeting:

You are hereby cited and admonished to be and appear at a Court of Appeals of the District of Columbia, upon the docketing the cause therein under and as directed by the rules of said court, pursuant to an appeal noted in the supreme court of the District of Columbia on the 1st day of July, 1896, wherein Alfred L. Bernardin, relator, is appellant and you are appellee, to show cause, if any there be, why the judgment rendered against the said appellant should not be corrected and why speedy justice should not be done to the parties in that behalf.

Seal Supreme Court of the District of Columbia.

Witness the Honorable Edward F. Bingham, chief justice of the supreme court of the District of Columbia, this 2d day of July, in the year of our Lord one thousand eight hundred and ninety-six.

JOHN R. YOUNG, *Clerk.*

Service of the above citation accepted this 2 day of July, 1896.

W. A. MEGRATH,
Attorney for Appellee.

S. T. FISHER,
Acting Com'r.

Supreme Court of the District of Columbia.

UNITED STATES OF AMERICA, *District of Columbia,* } *ss:*

I, John R. Young, clerk of the supreme court of the District of Columbia, do hereby certify the foregoing pages, numbered from 1 to 84, inclusive, to be true copies of originals in cause No. 40029, at law, wherein The United States *ex rel.* Alfred L. Bernardin is plaintiff and John S. Seymour, Commissioner of Patents, is defendant, as the same remain upon the files and records of said court.

Seal Supreme Court of the District of Columbia.

In testimony whereof I hereunto subscribe my name and affix the seal of said court, at the city of Washington, in said District, this 14th day of July, A. D. 1896.

JOHN R. YOUNG, *Clerk.*

Endorsed on cover: District of Columbia supreme court. No. 603. The United States *ex rel.* Alfred L. Bernardin, appellant, *vs.* John S. Seymour, Commissioner of Patents. Court of Appeals, District of Columbia. Filed Jul- 22, 1896. Robert Willett, clerk.

64 [Endorsed:] District of Columbia supreme court. No. 682. U. S. *ex rel.* Alfred L. Bernardin *vs.* Benjamin Butterworth, Commissioner of Patents. Court of Appeals, District of Columbia. Filed May 5, 1897. Robert Willett, clerk.

65 In the Court of Appeals of the District of Columbia.

UNITED STATES *ex Rel.* ALFRED L. BERNARDIN, Appellants, *vs.* BENJAMIN BUTTERWORTH, Commissioner of Patents, Appellee. } No. 682.

Now comes here the appellant and moves the court that the printing of the record in this case be dispensed with, and for cause thereof shows to the court the stipulation this day filed between counsel for the respective parties.

JULIAN C. DOWELL,
Attorney for Appellant.

Endorsed: Court of Appeals, D. C., April term, 1897. No. 682. United States *ex rel.* Alfred L. Bernardin, appellant, *vs.* Benjamin Butterworth, Commissioner of Patents. Motion to dispense with printing. Court of Appeals, District of Columbia. Filed May 7, 1897. Robert Willett, clerk.

66 In the Court of Appeals of the District of Columbia.

UNITED STATES *ex Rel.* ALFRED L. BERNARDIN, Appellant, *vs.* BENJAMIN BUTTERWORTH, Commissioner of Patents, Appellee. } No. 682.

It is stipulated and agreed between counsel for the respective parties to the above cause that the petition of the appellant herein is based upon the same state of facts as the petition in the case of The United States *ex rel.* Alfred L. Bernardin *vs.* John S. Seymour, Commissioner of Patents, before the Court of Appeals, October term, 1896, No. 603, which latter case abated by reason of the resignation of John S. Seymour of the office of Commissioner of Patents, and that the issues in this case are the same as the issues in the aforesaid case No. 603, wherein it was adjudged by this court that the judgment of the supreme court dismissing the petition for a writ of

mandamus be affirmed. Wherefore it is agreed that with the consent of the court the record herein need not be printed.

JULIAN C. DOWELL,
Attorney for Appellant.
W. A. MEGRATH,
Attorney for Appellee.

Endorsed: Court of Appeals, D. C., April term, 1897. No. 682. United States *ex rel.* Alfred L. Bernardin, appellant, *vs.* Benjamin Butterworth, Commissioner of Patents. Stipulation of counsel. Court of Appeals, District of Columbia. Filed May 7, 1897. Robert Willett, clerk.

67 MONDAY, *May 10th, A. D.* 1897.

UNITED STATES *ex Rel.* ALFRED L. BERNARDIN, Appellant,
vs.
BENJAMIN BUTTERWORTH, Commissioner of Patents. } No. 682.

On motion of Mr. Julian C. Dowell, of counsel for the appellant, it is ordered by the court that the printing of the record in the above-entitled cause be dispensed with, as per stipulation of counsel. Whereupon this cause was submitted to the consideration of the court on the transcript of record filed herein.

68 UNITED STATES *ex Rel.* ALFRED L. BERNARDIN, Appellant,
vs.
BENJAMIN BUTTERWORTH, Commissioner of Patents. } No. 682.

Opinion.

The allegations of the petition for the writ of mandamus prayed for in this case to Benjamin Butterworth, Commissioner of Patents, are substantially the same as those contained in the former petition filed by the same plaintiff against John S. Seymour, as Commissioner, and the same may be said of the returns made by each defendant to the writ. There is one error in the petition concerning the ending of the former suit, however, that should be noted. The allegation is that the former suit abated in this court because of the retirement of Commissioner Seymour from the said office and the succession of Commissioner Butterworth. The change in the office did not occur until April 12, 1897, and the judgment in the former case affirmed the judgment appealed from on March 1, and the mandate was issued to the court below on April 10, after a motion for a reargument had been overruled.

The case has been submitted on the argument made in the former case and involves but the one question, namely, the constitutionality of the act of Congress conferring upon this court the jurisdic-

tion to entertain appeals from the decisions of the Commissioner of Patents in certain cases. For the reasons given in the opinion in that case the judgment must be affirmed, with costs; and it is so ordered.

SETH SHEPARD,
Associate Justice.

69 TUESDAY, *May 11th, A. D.* 1897.

UNITED STATES *ex Rel.* ALFRED L. BERNARDIN, Appellant,
vs.
BENJAMIN BUTTERWORTH, Commissioner of Patents.
No. 682. April Term, 1897.

Appeal from the supreme court of the District of Columbia.

This cause came on to be heard on the transcript of record from the supreme court of the District of Columbia and was argued by counsel. On consideration whereof, it is now here ordered and adjudged by this court that the judgment of the said supreme court in this cause be, and the same is hereby, affirmed with costs.

Per MR. JUSTICE SHEPARD.

May 11, 1897.

70 TUESDAY, *May 25th, A. D.* 1897.

UNITED STATES *ex Rel.* ALFRED L. BERNARDIN, Appellant,
vs.
BENJAMIN BUTTERWORTH, Commissioner of Patents.
No. 682.

On motion of Mr. J. C. Dowell, attorney for the appellant in the above-entitled cause, it is ordered by the court that a writ of error to remove said cause to the Supreme Court of the United States be, and the same is hereby, allowed on giving bond in the sum of three hundred dollars.

71 Know all men by these presents that we, Alfred L. Bernardin, as principal, and Oscar C. Fox, as surety, are held and firmly bound unto Benjamin Butterworth, Commissioner of Patents, in the full and just sum of three hundred dollars, to be paid to the said Benjamin Butterworth, Commissioner of Patents, his certain attorney, executors, administrators, or assigns; to which payment, well and truly to be made, we bind ourselves, our heirs, executors, and administrators, jointly and severally, by these presents. Sealed with our seals and dated this 28th day of May, in the year of our Lord one thousand eight hundred and ninety seven.

Whereas lately, at a Court of Appeals of the District of Columbia, in a suit depending in said court between Alfred L. Bernardin and Benjamin Butterworth, a judgment was rendered against the said Alfred L. Bernardin, and the said Alfred L. Bernardin have come into court and prayed that a writ of error to the Supreme Court of

the United States be granted him, which was done, having obtained said writ and filed a copy thereof in the clerk's office of the said court to reverse the judgment in the aforesaid suit, and a citation directed to the said Benjamin Butterworth, Commissioner, citing and admonishing him to be and appear at a Supreme Court of the United States, to be holden at Washington within 30 days from the date thereof:

Now, the condition of the above obligation is such, that if the said Alfred L. Bernardin shall prosecute said writ to effect, and answer all damages and costs if he fail to make his plea good, then the above obligation to be void; else to remain in full force and virtue.

ALFRED L. BERNARDIN. [SEAL.]
OSCAR C. FOX. [SEAL.]

Sealed and delivered in the presence of—
ALEXANDER GILCHRIST.
CURRAN A. D. BRUSH.
CHAS. E. RIORDON.

Bond satisfactory.
W. A. MEGRATH,
Counsel for Com'r of Patents.

Approved by—
R. H. ALVEY, *Ch. Justice.*

72 STATE OF INDIANA, } ss:
Vanderburgh County, }

Before me, a notary public within and for the county and State aforesaid, this day personally came Alfred Bernardin and duly acknowledged the execution of the foregoing bond. Witness my hand and official seal this 28th day of May, 1897.

E. M. BINGEL,
Notary Public, V. C.

[Endorsed:] No. 682. U. S. *ex rel.* Alfred L. Bernardin *vs.* Benjamin Butterworth, Commissioner of Patents. Bond on appeal to Supreme Court U. S. Court of Appeals, District of Columbia. Filed Jun- 7, 1897. Robert Willett, clerk.

73 UNITED STATES OF AMERICA, ss:

The President of the United States to the honorable the judges of the Court of Appeals of the District of Columbia, Greeting:

Because in the record and proceedings, as also in the rendition of the judgment of a plea which is in the said Court of Appeals, before you or some of you, between United States *ex rel.* Alfred L. Bernardin, appellant, and Benjamin Butterworth, Commissioner of Patents, appellee, a manifest error hath happened, to the great damage of the said appellant, as by his complaint appears, we, being willing that error, if any hath been, should be duly corrected and

full and speedy justice done to the parties aforesaid in this behalf, do command you, if judgment be therein given, that then, under your seal, distinctly and openly, you send the record and proceedings aforesaid, with all things concerning the same, to the Supreme Court of the United States, together with this writ, so that you have the same in the said Supreme Court, at Washington, within 30 days from the date hereof, that, the record and proceedings aforesaid being inspected, the said Supreme Court may cause further to be done therein to correct that error what of right and according to the laws and customs of the United States should be done.

Witness the Honorable Melville W. Fuller, Chief Justice of the United States, the 7th day of June, in the year of our Lord one thousand eight hundred and ninety-seven.

Seal Court of Appeals, District of Columbia.

ROBERT WILLETT,
Clerk of the Court of Appeals of the District of Columbia.

74 UNITED STATES OF AMERICA, *ss:*

To Benjamin Butterworth, Commissioner of Patents, Greeting:

You are hereby cited and admonished to be and appear at a Supreme Court of the United States, at Washington, within 30 days from the date hereof, pursuant to a writ of error filed in the clerk's office of the Court of Appeals of the District of Columbia, wherein United States *ex rel.* Alfred L. Bernardin is plaintiff in error and you are defendant in error, to show cause, if any there be, why the judgment rendered against the said plaintiff in error, as in the said writ of error mentioned, should not be corrected and why speedy justice should not be done to the parties in that behalf.

Witness the Honorable R. H. Alvey, Chief Justice of the Court of Appeals of the District of Columbia, this 7 day of June, in the year of our Lord one thousand eight hundred and ninety-seven.

R. H. ALVEY,
Chief Justice of the Court of Appeals of the District of Columbia.

Service accepted June 7, 1897.

W. A. MEGRATH,
Counsel for Com. of Patents.

[Endorsed:] Court of Appeals, District of Columbia. Filed Jun- 7, 1897. Robert Willett, clerk.

75 Court of Appeals of the District of Columbia.

I, Robert Willett, clerk of the Court of Appeals of the District of Columbia, do hereby certify that the foregoing is a true and complete transcript of the record and all proceedings in said Court of Appeals in the case of United States *ex rel.* Alfred L. Bernardin, appellant, *vs.* Benjamin Butterworth, Commissioner of Patents,

No. 682, April term, 1897, as the same remains upon the files and records of said Court of Appeals.

Seal Court of Appeals, District of Columbia.

In testimony whereof I hereunto subscribe my name and affix the seal of said Court of Appeals, at the city of Washington, this 15th day of June, A. D. 1897.

ROBERT WILLETT,
Clerk of the Court of Appeals of the District of Columbia.

Endorsed on cover: Case No. 16,617. District of Columbia Court of Appeals. Term No., 404. The United States *ex rel.* Alfred L. Bernardin, plaintiff in error, *vs.* Benjamin Butterworth, Commissioner of Patents. Filed June 28th, 1897.

No. 404.

Motion Papers for P. C.

In the Supreme Court of the United States.

Filed Feb. 21, 1898.

THE UNITED STATES *ex Rel.*

ALFRED L. BERNARDIN,

Plaintiff in Error,

vs.

BENJAMIN BUTTERWORTH,

Commissioner of Patents.

October Term, 1897.

No. 404.

And now comes Alfred L. Bernardin, by Julian C. Dowell, his attorney, and, stating to the Court that Benjamin Butterworth, the defendant in error in the above-entitled action, deceased on the 16th day of January, 1898, whereby the office of Commissioner of Patents became vacant, and that, since that time, Charles H. Duell has been duly nominated, confirmed and commissioned to the office of Commissioner of Patents and has taken the oath and assumed, and is now exercising, the duties of said office of Commissioner of Patents, asks leave of the Court:

To substitute the name of Charles H. Duell upon the record in the above-entitled case in the stead and place of that of Benjamin Butterworth, in order that the said case may proceed to hearing and judgment as if the said Charles H. Duell had been originally the party defendant thereto;

And moves that the Court make any order or orders necessary to carry into effect the purposes of this motion.

JULIAN C. DOWELL,
Attorney for Alfred L. Bernardin.

I consent that the foregoing substitution be made.

C. H. DUELL,
Commissioner of Patents.

February 19, 1898.

IN THE SUPREME COURT OF THE UNITED STATES.

THE UNITED STATES *ex Rel.* ALFRED L. BERNARDIN, *Plaintiff in Error,* *vs.* BENJAMIN BUTTERWORTH, Commissioner of Patents.	October Term, 1897. No. 404.

In re Motion to substitute Hon. C. H. Duell, Present Commissioner of Patents, as Defendant in Error in Place of the Hon. Benjamin Butterworth, Deceased.

STATEMENT OF FACTS.

The Commissioner of Patents, March 23, 1895, on appeal in an interference proceeding between applications of Alfred L. Bernardin and his employee, William H. Northall, decided that Bernardin is the inventor and is entitled to a patent for the invention involved in the interference. Appeal from this decision was taken by Northall to the Court of Appeals of the District of Columbia, which Court reversed the decision of the Commissioner.

Mandamus proceedings were then commenced by Bernardin in the Supreme Court of the District of Columbia, to compel the Commissioner to issue a patent in accordance with his decision, on the ground that, notwithstanding the Act of Congress, approved February 9, 1893, in form, confers jurisdiction upon the Court of Appeals of the District of

Columbia to hear the appeal on error prosecuted from the action of the Commissioner of Patents, an officer of the executive department of the Government, and to review the official action of said officer of the executive department and to revise or reverse or nullify said action, said statute is, to the extent that it attempts to confer jurisdiction upon the Court of Appeals of the District of Columbia to review, reverse, or nullify the action of the executive branch of the Government, unconstitutional, inoperative and void, and the decision rendered and certified in that behalf *coram non judice* for want of constitutional authority to entertain, hear, and control by judicial action the official acts of the executive department. (Transcript, p. 5.)

The Supreme Court of the District of Columbia dismissed the petition for mandamus; and an appeal from this dismissal was taken by Bernardin to the Court of Appeals, which court sustained the dismissal of the petition for mandamus, but, at the same time, said they " were *not without doubt* in respect of the soundness " of their judgment as to the constitutionality of the law in question (Bernardin *vs.* Seymour, 79 O. G., 1190).

Writ of error would then have been taken to the Supreme Court, and it was so understood when the decision of the Court of Appeals was rendered; but *Commissioner Seymour* almost immediately *resigned* his office. Bernardin was compelled to pay costs and, on account of this resignation, to commence proceedings *de novo*.

On April 12, 1897, Benjamin Butterworth became Commissioner. The new petition for mandamus was filed in the Supreme Court of the District of Columbia, April 17, 1897, and this was dismissed. Appeal was then taken to the Court of Appeals; and the decision of the Supreme Court of the District of Columbia was affirmed May 11th upon the grounds set forth in the opinion in Bernardin *vs.* Seymour.

Bernardin was again compelled to pay costs.

On May 25, 1897, a writ of error was allowed to the Supreme Court of the United States and the case has proceeded to the printing of the record and preparation for hearing on its merits.

On January 16, 1898, *Commissioner Butterworth deceased;* and the present motion asks leave of the Court to substitute the present Commissioner, Charles H. Duell, in his stead.

Commissioner Duell consents to this substitution.

It will thus be seen that Bernardin has been compelled to pay costs *twice;* and the question now arises whether he should *again* be compelled to incur the same costs in order to get the case before Your Honors. *If this motion is overruled,* it can *have no other effect.*

POINTS.

There are three cases pertinent to be considered in relation to the case at bar. We will discuss them in order.

They are—

The Secretary *vs.* McGarrahan, 9 Wall., 298;
United States *vs.* Boutwell, 17 Wall., 604;
Thompson *vs.* United States, 103 U. S., 480.

In The Secretary *vs.* McGarrahan, 9 Wall., 298, Browning, the Secretary, *resigned four months before the decision* of the Supreme Court of the District of Columbia, but the mandamus was directed to him *or to his successor in office.* No notice or other steps were taken to make Cox, his successor, a party. There was no question of substitution. One of the

grounds, if not the main ground, for the decision, found in the language of Mr. Justice Clifford, is:

> "* * * the present Secretary may well complain that he is adjudged to be in default though he never refused to allow the relator to purchase the land, and that the judgment was rendered against him without notice and without any opportunity to be heard.
>
> "Notice to the defendant, actual or constructive, is essential to the jurisdiction of all courts, * * *."

This reason, of course, does not apply where the question is one of substitution and the party to be substituted voluntarily submits thereto, as in the case at bar.

United States *vs.* Boutwell, 17 Wall., 604, might be considered a precedent for the case at bar, except that the official to be substituted *opposed the substitution.* A mandamus was refused by the Supreme Court of the District of Columbia to compel Boutwell, Secretary of the Treasury, to pay an order. *After error was taken to the Supreme Court,* Boutwell resigned, and Richardson was appointed. *Counsel moved for leave to substitute Richardson.* No demand had been made on *Richardson* to pay the draft, and he *opposed* the substitution. Speaking by Mr. Justice Strong, the Court said (italics mine):

> "But no matter out of what facts or relations the duty has grown, what the law regards and what it seeks to enforce by a writ of mandamus, is the *personal obligation* of the individual to whom it addresses the writ. If he be an officer, and the duty be an official one, still the writ is aimed exclusively against him as a person, and he only can be punished for disobedience. The writ does not reach the office. It cannot be directed to it. It is, therefore, in substance a personal action, and it rests upon the averred and assumed fact that the defendant has neglected or refused to perform a

personal duty, to the performance of which by him the relator has a clear right. Hence it is an imperative rule that previous to making application for a writ to command the performance of any particular act, *an express and distinct demand or request to perform it must have been made* by the relator or prosecutor upon the defendant, and it must appear that he *refused to comply* with such demand, either in direct terms or *by conduct from which a refusal can be conclusively inferred.* Thus it is the personal default of the defendant that warrants impetration of the writ, and if peremptory mandamus be awarded, the costs must fall upon the defendant.

"It necessarily follows from this, that on the death or retirement from office of the original defendant, the writ must abate in the absence of any statutory provision to the contrary. When the personal duty exists only so long as the office is held, the court cannot compel the defendant to perform it after his power to perform has ceased. And if a successor in office may be substituted, he may be *mulcted in costs for the fault of his predecessor, without any delinquency of his own.* Besides, were a demand made upon him, he might discharge the duty and render the interposition of the court unnecessary. At all events, he is not in privity with his predecessor, much less is he his predecessor's personal representative. As might be expected, therefore, we find no case in which such a substitution as is asked for now has ever been allowed in the absence of some statute authorizing it. * * *

"And, even if the retirement of the defendant from office and his consequent inability to perform the act demanded to be done does not abate the writ, or necessitate its discontinuance, there is still an insuperable difficulty in the way of our directing the substitution asked for. *We can exercise only appellate power.* We have no original jurisdiction in the case. But any summons issued, or *rule* upon Mr. Richardson requiring him to become a party to the suit, would be the exercise of *original jurisdiction* over both a new party and a

new cause, for the duty which he would be required to perform would be his own, not that of his predecessor."

It will be seen that the argument made by the court—that the party to be substituted might be mulcted for costs without fault of his own—can have no force where demand has been made upon such party and he refuses to comply therewith, or where, as in the case at bar, he voluntarily submits to the jurisdiction. Nor does it seem to be sound in the case at bar for another reason; for, as counsel is informed, there can be little doubt that, were it necessary, the costs of the present suit would be defrayed out of the *contingent fund* of the *Interior Department* or out of the amount provided by the annual appropriation acts. (See Act of February 19, 1897, 29 Stats. at L., 569, etc.) "For investigating the question of the public use or sale of inventions for two years or more prior to filing applications for patents, and for *expenses attending defense of suits instituted against the Commissioner of Patents.*" And certainly the Government would not be wronged by the substitution, because, whatever costs it had to pay in any event would be due to an act of one or the other or both of its officers, through whom equally it acts and for whose actions equally it should be responsible.

Moreover, in the case at bar, it cannot be said that the present Commissioner has not had demand made upon him or refused to comply with that demand "by conduct from which a refusal can be conclusively inferred;" for he *voluntarily submits* to the substitution of his name as party defendant.

As to the other objection, it will be observed that, in the case at bar, there need be no exercise of *original* jurisdiction in the shape of a "rule" upon the new Commissioner; for he *voluntarily* becomes a party. And the only exercise of

power by the Court, even should the lower court be overruled, will be, it would seem, an exercise of *appellate* jurisdiction.

Moreover, the question arises whether the case at bar does not come within the exception expressly laid down by the Court in its opinion: that is, are not such suits, in the District of Columbia, excepted by *statute* from abatement by death?

In this connection, let us look at the 80th chapter, section 1, of the Maryland Act of 1785, which became law in the District of Columbia at the time of the cession thereof for the seat of government (italics mine):

> "*No* action, brought or to be brought, in any court of law in this District [State] *shall* abate by the *death* of *either of the parties* to such action, but upon the death of any defendant, in a case *where the action by such death would have abated before this act*, the action shall be continued, and the heir, devisee, executor or administrator, of the defendant, as the case may require, *or other person interested on the part of the defendant may* appear to such action; * * * ."

This statute does not seem to have been called to the attention of the Court when U. S. *vs.* Boutwell was decided.

It is true that this statute uses the words "heir," "devisee," etc., as the persons who are to be substituted, but this, we submit, is because such persons are the ones most commonly substituted for a deceased party; and that the statute was not intended to be limited to them is seen from the use of the expression "or other person interested on the part of the defendant." The spirit, if not the wording, of this phrase covers the case at bar; and this, especially, when we consider that the act says; "*No* action * * * shall abate * * * in a case *where the action by such death would have abated before this act* * * * ." Moreover, the use of the word "shall" in the first part of the act and

"may" in the latter part is significant as showing an intent that *no* action shall abate and an *enumeration* merely of *some*, but not of all, persons who *may* be substituted.

In Thompson *vs.* U. S., 103 U. S., 480, a mandamus was issued against a clerk of a township in Michigan to compel him to make and deliver to the supervisor a certified copy of a judgment against the township in order that it might be placed upon the tax-roll for collection. The clerk resigned before the rule to show cause was served on him, and set up this as a defense. The case came up to the Supreme Court on writ of error.

The Court, speaking by Mr. Justice Bradley, said (italics mine):

> "But *we cannot accede to the proposition that proceedings in mandamus abate by the expiration of the term of office of the defendant where*, as in this case, *there is a continuing duty irrespective of the incumbent*, and the proceeding is undertaken to enforce an obligation of the corporation or municipality to which the office is attached. * * * The proceedings may be *commenced with one set of officers and terminate with another*, the latter being bound by the judgment. * * *
>
> "If the resignation of the officer should involve an abatement, *we would always have the unseemly spectacle of constant resignations and reappointments to avoid the effect of the suit.* * * *
>
> "*The cases in which it has been held by this Court that an abatement takes place by the expiration of the term of office have been those of officers of the Government*, whose alleged delinquency was *personal*, and did not involve any charge against the Government whose officers they were. *A proceeding against the Government would not lie.* The Secretary *vs.* McGarrahan, 9 Wall., 298; United States *vs.* Boutwell, 17 *Id.*, 604"

It will readily be seen that many of the reasons assigned by the Court in Thompson *vs.* U. S. for holding that the suit *did not abate*, apply equally in U. S. *vs.* Boutwell (as well as

in the case at bar) where they held that it *did abate;* and, indeed, the *only* reason of any weight that can be or was assigned for the distinction between the rulings in the two cases is that a mandamus proceeding against an officer of the Government is *especially personal* because the *Government itself cannot be sued.* But it would seem as if this argument loses much, if not all, of its weight in the case at bar when we consider that the present Commissioner voluntarily submits to the substitution of his name and to any judgment or costs that may result therefrom. Moreover, it will be noted, by an examination of the opinion in U. S. *vs.* Boutwell, that the ground—that the Government cannot be sued—alleged in the opinion in Thompson *vs.* U. S., as shown in the last paragraph above quoted, for the distinction between that case and U. S. *vs.* Boutwell, *was not even hinted at in U. S.* vs. *Boutwell itself* as a reason therefor.

Three other decisions have been rendered by Your Honors, to which we will briefly call your attention. Two of these are memorandum decisions: U. S. *ex rel.* Long *vs.* Lochren, 164 U. S., 701, and U. S. *ex rel.* Warden *vs.* Chandler, 122 U. S., 643. They both were dismissed *on the authority of U. S.* vs. *Boutwell.* In *all* these cases, unlike the case at bar, *there was no consent to the substitution.*

The other case is Warner Valley Stock Company *vs.* Smith, 165 U. S., 28, which was a suit in equity for an injunction, which was in effect a mandamus, filed in the Supreme Court of the District of Columbia against Hoke Smith, Secretary of the Interior, and Silas W. Lamoreaux, Commissioner of the General Land Office. The Court held that the suit abated upon the resignation of Smith and *could not be prosecuted against Lamoreaux alone.* Smith was, in fact the main party to the suit. The case is not directly in point, except that, as to Secretary Smith, though the case was in equity and not a mandamus proceeding, the Court applied the rule of abatement laid down in U. S. *vs.* Boutwell, thus

substantially reaffirming the soundness of that rule in mandamus proceedings against Government officers. It will be noted that the appellees defended, and *did not consent;* and that the Court simply ordered that the case be remanded with directions to *dismiss the bill for want of parties.*

The three cases, not above referred to but cited in Mr. Justice Gray's opinion in Warner Valley Stock Co. *vs.* Smith, *supra*, viz: Commissioners *vs.* Sellew, 99 U. S., 624; U. S. *vs.* Schurz, 102 U. S., 378, 408; and U. S. *vs.* Lamont, 155 U. S., 303, 306, will be seen, upon examination, not to be in point.

In Commissioners *vs.* Sellew, the writ was against a county and was directed to it in its corporate name; and the only real question was whether the "writ was properly directed to the board in its corporate capacity."

In U. S. *vs.* Schurz, the question was whether the case presented *entitled petitioner to a mandamus* to compel the delivery of a patent to certain public lands, or whether he was still clothed with discretion.

In U. S. *vs.* Lamont, quoting from the syllabus, it was held:

> "* * * the Secretary of War cannot be required by mandamus to sign a contract for the performance of work by a party who is already under written contract with him to perform the same work for the Government at a lower price and under different conditions."

Upon this showing, we respectfully submit that this motion ought to be allowed, and that it can be allowed without overruling any of the former decisions of the Court; while, at the same time, Your Honors will be doing an act of justice in relieving the relator of the onerous burden of being *compelled to pay costs for the third time*, with possibly a repetition of this requirement indefinitely.

Respectfully submitted,

JULIAN C. DOWELL,

Attorney for Bernardin.

Reply to Briefs Filed in Opposition to Motion for Substitution.

What has already been said seems to be a sufficient answer to the brief filed by counsel for the Crown Cork and Seal Company, a Baltimore corporation interested in defeating the issue of a patent to Bernardin.

A brief in opposition has also been filed by the Hon. John K. Richards, Solicitor-General, in view of which the following suggestions are respectfully submitted.

The opening statement of the brief of the Hon. Solicitor-General indicates an apparent misconception of the origin of this case and the merits thereof.

The case grows out of a contest between Alfred L. Bernardin, president and superintendent of the Bernardin Bottle Cap Company, of Evansville, Indian, manufacturers of bottle-sealing devices, and a salaried employee of the Bernardin Company, acting in the interest of the Crown Cork and Seal Company, a competitor of the Bernardin Company, in the manuafacture of bottle caps or bottle-sealing devices (one of which devices is the subject of this controversy). (Transcript, pages 25 and 45 *et seq.*)

The record shows that Bernardin filed an application for a patent for a bottle-sealing device, which was allowed, though the patent did not issue immediately, because, in contemplation of taking out foreign patents, Bernardin deferred for a few months after notice of allowance the payment of the final Government fee (six months from the official notice of allowance being allowed by law for this purpose) and, in the meantime, knowledge of Bernardin's invention was brought to the attention of the Crown Cork and Seal Company, whose secretary and business manager, William Painter, filed an application for a patent for the same invention, and thereafter,

through a correspondence between the representative of the aforesaid corporation and the attorney of the said Northall, the latter filed an application for a patent, which was also placed in interference with Bernardin. (Transcript, pages 25 and 45.) This interference was decided by the Commissioner of Patents in favor of Bernardin; but, on appeal to the Court of Appeals of the District of Columbia, the decision of the Commissioner was reversed, whereupon mandamus proceedings were instituted as herein before recited.

The question involved is one of great importance, not only to Bernardin, but the general public, and the Hon. Benjamin Butterworth, as Commissioner of Patents, while denying the request of Bernardin to have the patent issue to him in accordance with the decision of Mr. Butterworth's predecessor, Hon. John S. Seymour, solely because of the decision of the Court of Appeals, expressed the opinion that the statute conferring jurisdiction on said court in such cases is *unconstitutional*, "*because it confuses and obliterates the lines which mark the boundary between the several departments of the Government and makes one subordinate to another.*" (Transcript, p. 8.)

And in conclusion Mr. Butterworth said—

> "I trust if any step is to be taken it may be done immediately, in order that no time be lost in having this question finally settled." (*Ibid.*, p. 10.)

And the importance of the question and the desirability of having it speedily determined by this Court is shown by the concluding clause of the opinion of the Court of Appeals of the District of Columbia, wherein the Court said—(italics mine):

> "Without further prolonging the discussion of this interesting question, and *admitting that we are not without doubt in respect of the soundness of our judgment*, we

repeat that we have not been able to see our way to the conclusion urged upon us—namely, that the act conferring the right of appeal to this court from the decisions of the Commissioner of Patents is beyond the power of Congress to enact, for the reason that it oversteps the boundaries erected by the Constitution between the three great departments of the Government."

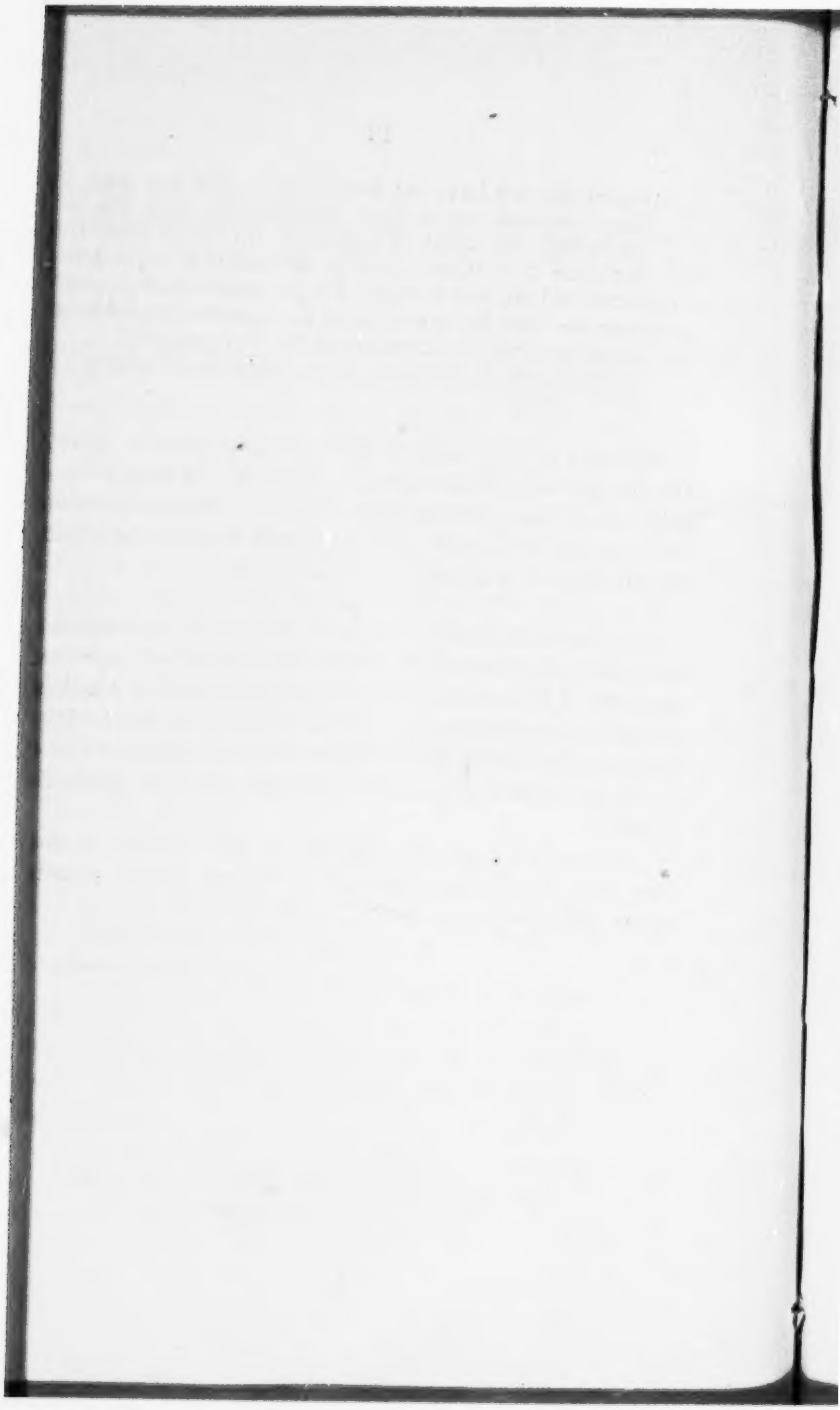
(Bernardin *vs.* Seymour, Commissioner of Patents, 79 O. G., 1194.)

A denial of this motion will not only place a heavy burden on Bernardin, compelling him to pay costs a *third time*, but it defers the determination of a mooted question, which, I submit, should be speedily and finally determined by this Court in the interest of the public.

If this action and all subsequent actions of like character are to abate because of the *resignation* or *death* of the Commissioner of Patents, it is exceedingly problematical whether the case will ever be brought before this Court for its decision, for the reason that the office of Commissioner of Patents is subject to frequent and periodical changes by resignations or otherwise.

I respectfully submit, in view of the consent of the Hon. C. H. Duell, Commissioner of Patents, to the substitution, that the motion should be granted.

JULIAN C. DOWELL,
Attorney for Alfred L. Bernardin.



No. 404.

IN THE SUPREME COURT OF THE UNITED STATES.

THE UNITED STATES *ex Rel.* ALFRED L. BERNARDIN, *Plaintiff in Error,* *vs.* BENJAMIN BUTTERWORTH, Commissioner of Patents.

October Term, 1897. No. 404.

In re Motion to substitute Hon. C. H. Duell, Present Commissioner of Patents, as Defendant in Error in Place of the Hon. Benjamin Butterworth, Deceased.

PROFESSIONAL STATEMENT.

In an interview with the Solicitor-General subsequent to the filing of his opposition to the motion for a substitution of Mr. Duell for Mr. Butterworth, he stated to me, and consented that I say to the Court, that his objection to the granting of the motion is based solely on the legal ground that, under the law as construed by this Court the action has abated by the death of Mr. Butterworth; that he understands the Patent Office earnestly desire to have the constitutional question involved in the controversy finally settled; and that if it shall seem proper to the Court, under the special circumstances of this case, to grant the motion, he does not object thereto.

Very respectfully,
JULIAN C. DOWELL,
Attorney for Bernardin.

No. 404.

Brief of Wilson for D. E.

IN THE

Supreme Court of the United States.

Filed Feb. 25, 1893.

THE UNITED STATES *ex rel.* ALFRED BERNARDIN, Plaintiff in Error,

vs.

BENJAMIN BUTTERWORTH, Commissioner of Patents.

No. 404.

In re Motion to Substitute Hon. C. H. Duell, Present Commissioner of Patents, as Defendant in Error in Place of the Hon. Benjamin Butterworth, Deceased.

An inspection of the record will show that this case grows out of a contest between the said Alfred Bernardin and one Northall, in relation to the issuance of a patent upon a device for corking and sealing bottles. Which of the two was entitled to the patent was the subject-matter of contest on a declaration of interference, and afterwards on appeal in the Court of Appeals of the District of Columbia.

The Court of Appeals held that Northall was entitled to the patent, notwithstanding which decision Bernardin instituted proceedings for mandamus to compel the Commissioner of Patents to issue the patent to him. During the pendency of the case in this court, the Commissioner of Patents, the Hon. Benjamin Butterworth, died, and Mr. Duell was appointed his successor. The present motion is to substitute Mr. Duell for the former Commissioner.

It is submitted that by reason of the death of Mr. Butterworth the action has abated, and that it can not be revived as against the present Commissioner.

As my client, the Crown Cork and Seal Company, is not a party to the record, although the real party in interest adverse to the contention of the plaintiff in error, as I stated in open court, I will content myself with stating this proposition, to wit, that this record presents a case where the writ is aimed against a person and not against an office. It is in its nature a personal action, and rests upon the allegation that the performance of a personal duty has been refused.

United States v. *Boutwell*, 17 Wall., 604.

As stated in the opinion of Justice Gray in the case of *Warner Valley Stock Co.* v. *Smith* (165 U. S., 28, 31)—

"That a petition for a writ of mandamus to a public officer of the United States abates by his resignation of his office has been determined by a series of uniform decisions of this court, and has for years been considered

so well settled that in some of the cases no opinion has been filed and no official report published.

Secretary v. *McGarrahan*, 9 Wall., 298, 313;
United States v. *Boutwell*, 17 Wall, 604, 609;
Commissioners v. *Sellew*, 99 U. S., 626;
United States v. *Schurz*, 102 U. S., 378, 408;
Thompson v. *United States*, 103 U. S., 480, 484;
United States v. *Chandler*, 122 U. S., 643;
United States v. *Lamont*, 155 U. S., 303, 306;
United States v. *Long*, 164 U. S., 701."

I, therefore, submit that the motion of the plaintiff in error should be overruled.

J. M. WILSON,
Attorney for the Crown
Cork and Seal Co.

In the Supreme Court of the United States.

OCTOBER TERM, 1897.

THE UNITED STATES EX REL. ALFRED Bernardin, plaintiff in error, *v.* BENJAMIN BUTTERWORTH, Commissioner of Patents. } No. 404.

OPPOSITION TO MOTION FOR SUBSTITUTION.

This case grows out of a contest between Bernardin and one Northall with reference to the issuance of a patent. In the contest, on a declaration of interference, heard ~~and afterwards~~ on appeal in the court of appeals of the District of Columbia, it was held that Northall was entitled to a patent. Notwithstanding this decision, Bernardin instituted proceedings in mandamus against Benjamin Butterworth, praying the court to compel him as Commissioner of Patents to issue a patent to him. During the pendency of the case in this court Mr. Butterworth died and Mr. Duell was appointed his successor. Bernardin now moves to substitute Mr. Duell.

On behalf of the Government, and in support of its settled policy, I object to this substitution, because the action abated by the death of Mr. Butterworth. In effect a proceeding in mandamus is a personal action, resting upon the assumed fact that the defendant neglects or refuses to perform a duty imposed upon him by law. The writ is not directed against the office, but against the person holding the office.

The action abates when, by death or resignation, the defendant ceases to hold the office. *Non constat* but that his successor may perform the duty which he had refused to perform. (*United States* v. *Boutwell*, 17 Wall., 604, 609; *Warren Valley Stock Company* v. *Smith*, 165 U. S., 25, 31.)

It is submitted that the motion should be denied, and that the case should be dismissed.

JOHN K. RICHARDS,
Solicitor-General.

UNITED STATES, *ex rel.* BERNARDIN *v.* BUTTERWORTH.

ERROR TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

No. 404. Submitted February 21, 1898. — Decided March 21, 1898.

A suit to compel the Commissioner of Patents to issue a patent abates by the death of the Commissioner, and cannot be revived so as to bring in his successor, although the latter gives his consent.

The act of Maryland of 1785, c. 80, is not applicable to such a case.

Opinion of the Court.

THIS was a motion to substitute Mr. Duell, Commissioner of Patents as defendant in the place of Mr. Butterworth, Commissioner, deceased. The case is stated in the opinion.

Mr. Julian C. Dowell for the motion.

Mr. J. M. Wilson opposing.

MR. JUSTICE SHIRAS delivered the opinion of the court.

On March 23, 1895, John S. Seymour, Commissioner of Patents, on appeal in an interference proceeding between the applications of Alfred S. Bernardin and William H. Northall, decided that Bernardin was entitled to a patent for the invention involved in the interference. From this decision an appeal was taken by Northall to the Court of Appeals of the District of Columbia, and the decision of the Commissioner was by that court reversed.

Bernardin then instituted proceedings in the Supreme Court of the District of Columbia, seeking to compel the Commissioner to issue a patent in accordance with his previous decision, claiming that the act of Congress approved February 9, 1893, which, in form, confers jurisdiction upon the Court of Appeals of the District of Columbia to hear appeals from the action of the Commissioner of Patents, is unconstitutional and void, in that it attempts to confer jurisdiction upon that court to review or reverse the action of the Commissioner.

The Supreme Court of the District of Columbia dismissed the petition for mandamus, and, on appeal, the Court of Appeals of the District sustained the judgment of the Supreme Court. *Bernardin* v. *Seymour*, 10 App. D. C. 294.

Thereafter John S. Seymour resigned his office as Commissioner of Patents, and, on April 12, 1897, Benjamin Butterworth was appointed his successor. On April 17, 1897, Bernardin filed a new petition for mandamus in the Supreme Court of the District of Columbia, which was dismissed, and that decision was, on appeal to the Court of Appeals of the District, on May 11, 1897, affirmed.

On May 25, 1897, a writ of error was allowed from this court, and, while the case was here pending, on January 16, 1898, Benjamin Butterworth died, and C. H. Duell was thereafter appointed to the office thus left vacant; and a motion has been made for leave to substitute Duell in the stead of Butterworth, notwithstanding that by the death of the latter the action had abated.

The question thus presented is not a novel one. In *Secretary* v. *McGarrahan*, 9 Wall. 298, it was held that a judgment in mandamus ordering the performance of an official duty against an officer, as if yet in office, when in fact he had gone out after service of the writ, and before the judgment, is void, and cannot be executed against his successor. In *United States* v. *Boutwell*, 17 Wall. 604, it was held that, in the absence of statutory provision to the contrary, a mandamus against an officer of the government abates on his death or retirement from office, and that his successor in office cannot be brought in by way of amendment of the proceeding, or on an order for the substitution of parties. The conclusion reached was put upon two independent grounds, and we quote the reasoning of the court, expressed in its opinion delivered by Mr. Justice Strong, as follows:

"The office of a writ of mandamus is to compel the performance of a duty resting upon the person to whom the writ is sent. That duty may have originated in one way or in another. It may, as alleged in the present case, have arisen from the acceptance of an office which has imposed the duty upon its incumbent. But no matter out of what fact or relations the duty has grown, what the law requires, and what it seeks to enforce by a writ of mandamus, is the personal obligation of the individual to whom it addresses the writ. If he be an officer, and the duty be an official one, still the writ is aimed exclusively against him as a person, and he only can be punished for disobedience. The writ does not reach the office. It cannot be directed to it. It is, therefore, a personal action, and it rests upon the averred and assumed fact that the defendant has neglected or refused to perform a personal duty, to the performance of which by him the relator has a clear

right. Hence it is an imperative rule that previous to making application for a writ to command the performance of any particular act, an express or distinct demand or request to perform it must have been made by the relator or prosecutor upon the defendant, and it must appear that he refused to comply with such demand, either in direct terms or by conduct from which a refusal can be conclusively inferred. Thus it is the personal default of the defendant that warrants the impetration of the writ, and if a peremptory mandamus be awarded, the costs must fall upon the defendant. It necessarily follows from this, that on the death or retirement from office, the writ must abate in the absence of any statutory provision to the contrary. When the personal duty exists, only so long as the office is held, the court cannot compel the defendant to perform it after his power to perform has ceased. And if a successor in office may be substituted, he may be mulcted in costs for the default of his predecessor, without any delinquency of his own. Besides, were a demand made upon him, he might discharge the duty and render the interposition of the court unnecessary. In all events, he is not in privity with his predecessor, much less is he his predecessor's personal representative. . . .

"And even if the retirement of the defendant from office and his consequent inability to perform the act demanded to be done does not abate the writ, or necessitate its discontinuance, there is still an insuperable difficulty in the way of our directing the substitution asked for. We can exercise only appellate power. We have no original jurisdiction in the case. But any summons issued, or rule upon the successor in office, requiring him to become a party to the suit, would be an exercise of original jurisdiction over both a new party and a new cause, for the duty which he would be required to perform would be his own, not that of his predecessor."

In *Thompson* v. *United States*, 103 U. S. 480, the distinction is pointed out between proceedings where the obligation sought be enforced devolves upon a corporation or continuing body, and those where the duty is personal with the officer. In the former case there is no abatement. The duty is per-

petual upon the corporation; in the latter, the delinquency charged is personal, and involves no charge against the Government, against which a proceeding would not lie.

United States v. *Chandler*, 122 U. S. 643, was the case of a writ of error in review of a judgment of the Supreme Court of the District of Columbia refusing a mandamus against William E. Chandler, Secretary of the Navy, to require of him the performance of certain alleged official duties. When the case was called, it appeared that Mr. Chandler was no longer Secretary, and that the office was filled by his successor. Thereupon this court, upon the authority of *United States* v. *Boutwell*, held that the suit had abated, and dismissed the writ of error.

A similar view prevailed in *United States* v. *Lochren*, 164 U. S. 701.

In *Warner Valley Stock Company* v. *Smith*, 165 U. S. 28, the subject was considered at some length. There a bill had been filed against Hoke Smith, as Secretary of the Interior, to compel him to cause patents to be issued to the plaintiff for certain tracts of land. The Supreme Court of the District sustained a demurrer to the bill and dismissed the suit. While an appeal to this court was pending, Hoke Smith resigned his office, and it was held that the bill could not be amended by making his successor a defendant, because he was not in office before the bill was filed and had no part in the doings complained of, and accordingly the cause was remanded with directions to dismiss the bill. In discussing the case Mr. Justice Gray cited the cases just mentioned and several others to the same effect, and again pointed out the difference between the case of a public officer of the United States and that of a municipal board, which is a continuing corporation, although its individual members may be changed, to which in its corporate capacity a writ of mandamus may be directed; and in respect to which the language of Chief Justice Waite, in *Commissioners* v. *Sellew*, 99 U. S. 624, was quoted: "One of the objects in creating such corporations, capable of suing and being sued, and having perpetual succession, is that the very inconvenience which manifested itself in Boutwell's case may be avoided."

In the absence, therefore, of statutory authority, we cannot, after a cause of this character has abated, bring a new party into the case. Nor is the want of such authority supplied by the consent of a person not a party in the cause.

It is, however, contended that an act of the State of Maryland enacted in 1785, chapter 80, section 1, and which, it is claimed, became the law of the District of Columbia when the territory thereof was ceded to the United States, is applicable. The terms of said section are as follows:

"No action, brought or to be brought, in any court of this State shall abate by the death of either of the parties to such action, but upon the death of any defendant, in a case where the action by such death would have abated before this act, the action shall be continued, and the heir, devisee, executor or administrator of the defendant, as the case may require, or other person interested on the part of the defendant, may appear to such action."

It is suggested that the attention of this court was not called to this statute in the previous cases. However that may have been, we are unable to perceive that this statute, either in its terms or its spirit, is applicable to cases like the present one. Neither the heir, devisee, executor or administrator of a deceased official would have any legal interest in such a controversy. Nor, in the case of a resignation, could the successor be said to be "a person interested on the part of the defendant."

In view of the inconvenience, of which the present case is a striking instance, occasioned by this state of the law, it would seem desirable that Congress should provide for the difficulty by enacting that, in the case of suits against the heads of departments abating by death or resignation, it should be lawful for the successor in office to be brought into the case by petition, or some other appropriate method.

The motion is refused, and the judgment of the Court of Appeals is reversed, the costs in this court to be paid by the plaintiff in error, and the cause remanded to that court with directions to reverse the judgment of the Supreme Court of the District of Columbia and remand

the cause to that court with directions to dismiss the petition for the writ of mandamus because of the death of the defendant Butterworth.

MR. JUSTICE HARLAN, MR. JUSTICE BREWER and MR. JUSTICE PECKHAM dissented.